

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT. 2

PORTERVILLE CITRUS ASSOCIA-
TION, a corporation,

Appellant,

vs.

FRED STEBLER,

Appellee.

APPELLANT'S BRIEF

NICHOLAS A. ACKER,

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Filed

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F. D. Monckton,
Clerk.

IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

PORTERVILLE CITRUS ASSOCIA- TION, a corporation,	<i>Appellant,</i>	} In Equity No. 2960
vs.		
FRED STEBLER,	<i>Appellee,</i>	}
and		

MID-CALIFORNIA CITRUS ASSO- CIATION, a corporation,	<i>Appellant,</i>	} In Equity No. 2961
vs.		
FRED STEBLER	<i>Appellee.</i>	}

BRIEF OF APPELLANTS PORTERVILLE
CITRUS ASSOCIATION
and
MID-CALIFORNIA CITRUS ASSOCIATION.

These cases came before this Court on an appeal from the final decree made and entered in the above entitled suits November 20, 1916, by the United States District Court for the Southern District of California, Southern Division.

By stipulation between counsel appeal case 2961,

Mid-California Citrus Association, is to be heard on the printed records of appeal case No. 2960, Porterville Citrus Association, and abide by the decision of this Court rendered in connection with said appeal case No. 2960, and for this reason, the brief is entitled in the two appeal cases. This Stipulation appears on page 42 of the Transcript of Record, re appeal case No. 2961.

In the lower court three suits were instituted for infringement of Letters Patent, the same being, Fred Stebler vs. Porterville Citrus Association, Case No. A-44; Fred Stebler vs. Mid-California Citrus Association, Case No. A-45, and Fred Stebler vs. Porterville Citrus Association, Case No. A-50. In connection with case of Porterville Citrus Association A-44, and in connection with the case of Mid-California Citrus Association, A-45, appellants herein, the charge was for infringement of United States Re-issue Letters Patent No. 12,297 granted Robert Strain under date of Dec. 27, 1904, for an improved Fruit Grader (Complainants' Ex. 1, record page 511), and United States Letters Patent No. 943,799, granted Fred Stebler under date of December 21, 1909 (Complainants' Ex. 2, record page 516), for an improved DISTRIBUTING APPARATUS; while in suit No. A-44, entitled Stebler vs. Porterville Citrus Association, the action was for infringement of United States Letters Patent No. 775,015 granted Thomas Strain under date of Nov. 15, 1904 (Complainants' Ex. 3, record page 525). It was agreed at the hearing in the lower court and for the purpose of conserving time,

and inasmuch as the issues in case A-44 and A-50 were identical, that the two cases be heard together, and it was further agreed between counsel at the hearing that inasmuch as cases A-44 and A-45 involved the same issues as to the charge infringement, that A-45 should abide the issue in A-44, record page 105, Transcript of Record, appeal case No. 2960. These three cases came on for hearing in the lower court and the decision of said court held, non-infringement as to the Robert Strain re-issue patent No. 12,297, and as to the Thomas Strain Patent No. 775,015, and infringement of certain hereinafter specified claims of the Stebler patent 943,799. Case No. A-50 against Porterville Citrus Association for infringement of the Thomas Strain Patent No. 775,015 was dismissed for want of infringement, and no appeal had been taken by the complainant thereto from said decision.

The decision of the court rendered under date of August 1, 1916, holding non-infringement of the Thomas Strain patent No. 775,015, and the Robert Strain Re-issue patent No. 12,297, appears on page 27 of the printed Record, Appeal Case No. 2960. The decree of the lower court in connection with Equity Suit A-44, appeal case herein, No. 2960 appears on page 28 of the printed record. In this connection, it will be noted, that while the Minute Order or Decision of the Court on the question of infringement of the patents in suit, holds non-infringement of the Thomas Strain patent, and non-infringement of the Robert Strain patent, and provides that counsel for complainant prepare a de-

cree in accordance with the conclusions announced by the court, the decree so prepared by counsel for appellee and signed by His Honor, Oscar A. Trip pet, under date of Nov. 20, 1916, holds not only infringement as to Claims 1, 2, 3, 5, 6, 7, 8, 11, 14, 15, and 19 of the Fred Stebler patent No. 943,799, of December 21, 1909, but equally so, holds infringement of United States Re-issue Letters Patent No. 12,297, granted Robert Strain under date of December 27, 1904. Thus, at the outset we have a decree at variance with the order of the court, inasmuch as the decree provides for infringement of the Robert Strain re-issue letters patent, one of the patents held not to be infringement by the order of the court. However, it is the decree we are concerned with in connection with the present appeal, and shall confine ourselves thereto.

The Assignment of Errors, ten in number, appear between record pages 825 and 828, of the Transcript of Record, Appeal Case No. 2960, the first seven of the assignment of Errors being directed to error of the lower court in connection with the holding of infringement of the specified claims, of United States Letters Patent No. 943,799 granted Fred Stebler under date of December 21, 1909, the eighth assignment of errors being directed to the holding of infringement of the Re-issue Letters Patent No. 12,297.

STRAIN RE-ISSUE LETTERS PATENT.

These Letters Patent No. 12,297, have been be-

fore this Court in connection with several appeals taken from the decision of the lower court for the Southern District of California, it first appearing in connection with Appeal Case No. 2232, entitled, *Stebler vs. Riverside Heights Orange Growers' Association, et al.*, wherein this Court held the said Letters Patent to be valid and infringed (205 Fed. 735); and it last appeared before this Court in connection with Appeal Case No. 2772, *Riverside Heights Orange Growers' Association, et al., vs. Stebler*, and *Stebler vs. Riverside Heights Orange Growers' Association*, decision being reported in 240 Fed. 703. In connection with the latter appeal, this Court construed the Strain re-issue patent, more particularly Claims 1 and 10 thereof, in the light of its former decision reported in 205 Fed. 736, and pointed out what protection was afforded by claims 1 and 10 of the said Letters Patent, it being here stated, that in connection with the present appeal cases claims 1 and 10 of the Strain Re-issue Letters Patent were the only claims relied upon to establish infringement.

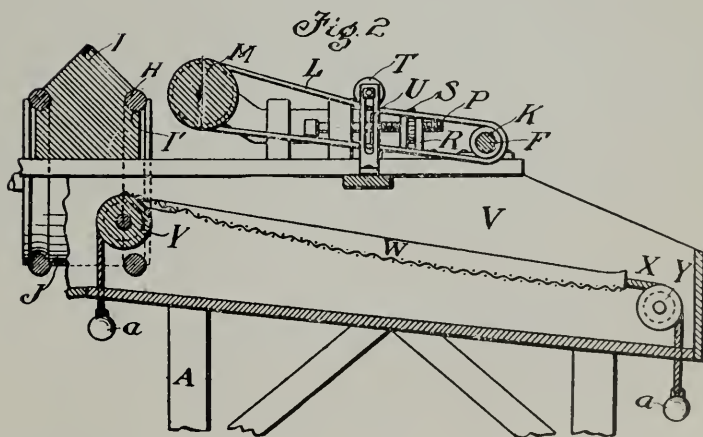
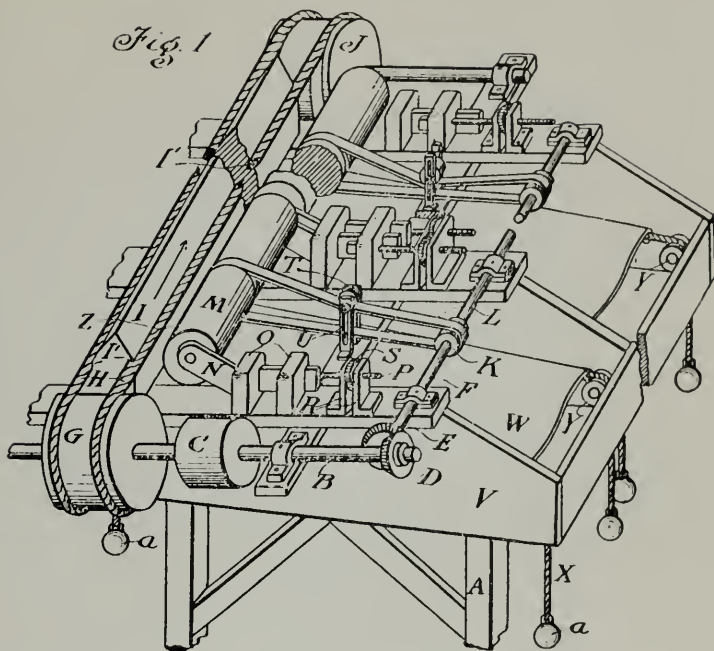
The Court is therefore familiar with the invention of the Strain Re-issue Letters Patent No. 12,297, and may remember that the fruit grader therein disclosed and covered by Claims 1 and 10 thereof comprise a fruit grader, consisting of a fruit runway composed of two parallel members, one of the said members being a rotating wall member composed of a series of end to end rolls, there being employed a traveling conveyor for propelling the fruit to be sized within the fruit

runway composed of the said two parallel members, there being a series of bins for receiving the sized fruit escaping from the fruit runway, located at one side of the rotating units of the rotary wall member. For the convenience of the Court, we herewith reproduce the drawings of the Strain Re-issue Patent No. 12,297, and by reference thereto, it will be noted that, as stated, the fruit sizer is composed of two parallel members. The fixed member of the grader being designated by the reference letter I, which member is grooved for the reception of a propelling rope H. The opposing member of the fruit grader consists of a series of end to end rollers M arranged in longitudinal succession the entire length of the grader, each roller M being rotatively mounted in adjustable bearing arms N, which arms have movement in the guide blocks O, and the rollers M are driven or rotated independently of each other by means of the drive belts L, which receives motion from a drive shaft F. Each roller is independently adjustable transversely toward and from the fixed guide member I through the medium of the adjustability permitted the adjusting arms N, which work in the guide blocks O. Under this construction each sizing roller is permitted adjustment independent of the other sizing rollers of the series of longitudinally disposed end to end rollers which constitute the rotating wall member or the companion member to the fixed parallel member I of the fruit runway.

Under the disclosure of the Strain Re-issue Let-

R. STRAIN.
FRUIT GRADER.

APPLICATION FILED OCT 21, 1903



Witnesses:

*William F. Kelly**Fredrick Shyon*

Inventor

Robert Strain

by *Thompson Bros*
Attys.

ters Patent it is absolutely essential that each roller of the series of disconnected rollers constituting the rotary wall member of the fruit runway be permitted independent and individual rotation. If the rollers were connected one to the other so as to be driven in unison, it would be impossible to impart independent transverse adjustment to one roller without correspondingly disturbing the position of the adjacent roller. It is the independent and individual adjustability and the independent and individual rotation of the respective rollers constituting the rotating wall member of the fruit grader of the Strain Re-issue Patent which differentiated it, or rather which caused this Court to differentiate the same from the prior Ish patent and the California fruit graders or sizers of the prior art.

In appeal case No. 2772, this Court held, the Parker Modified Type of Fruit Grader or Sizer not to be an infringement of the Strain Re-issue Letters Patent, stating, in connection with the Parker Modified Apparatus, and which is the sizing apparatus employed by these appellants and charged to be an infringement of claims 1 and 10 of the Strain Re-issue Patent:

“The construction of the grade openings formed by the rollers in the defendant’s modified apparatus is a return in a substantial construction to the prior art which this Court differentiated from the invention in suit to such an extent that it held that the latter had not been anticipated by such prior art. The rule applicable to the question thus presented is that

a construction which does not anticipate cannot infringe.”

Sandusky Tool Co. (U. S. S. Ct.) 28 L. Ed. 124; American Tobacco Co. vs. Streat, 83 Fed. 700-706, 28 C. C. A. 18; Cleveland Co. vs. Chicago Co., 135 Fed. 783, 68 C. C. A. 485; Grever vs. U. S. Hoffman Co., 202 Fed. 923-926, 121 C. C. A. 281.

But there is a further rule applicable to this question, and that is,

“If the device of the respondents shows a substantially different mode of operation, even though the results of the operations of the machine remains the same, infringement is avoided.”

Cimmotti Unhairing Co. vs. American Fur, Ref. Vo. 198 U. S. 399-414, 25 Sup. Ct. 697-702 (49 Law. Ed. 1100).

“The conclusion we reach is, that under the distinction drawn by this Court in its opinion (205 Fed. 735, 124 C. C. A. 29), the defendant’s modified apparatus is not an infringement of the patent in suit.”

240 Fed., pp. 709-710.

There is no question but what the fruit sizing apparatus employed in the packing house of each of the appellants herein, is the same as the Modified Parker machine held by this Court in appeal case No. 2772 to be a non-infringement of the said Strain Re-issue Letters Patent No. 12,297, for such is testified to by complainant Fred Stebler. His testimony given on page 133 Transcript of Record Appeal Case No. 2960, being:

“Q. (By Mr. Lyon): Now, you, Mr. Stebler,

also are familiar with the so-called Parker Modified Machines, which in case 1562 on the accounting before Lynn Helm as Master, and each shown to Lynn Helm at the Riverside Heights Orange Growers' Association?

"A. Yes sir.

"Q. In what manner or to what extent does the arrangement of the belt and the roller section in these defendants' machines at Porterville correspond or differ in function and effect from the inter-relation of the belts and roller sections in those modified machines?

"A. Why, there is really no material difference. There is some difference in detail of construction and the manner of making the roller mountings and placing them on the machines, but the corelation between the inclined conveyor belt and the roller is practically the same and the machines at the Riverside Heights Orange Growers' Association had means for varying the grade apertures between the roller and the belt by means of moving the roll adjusting the roller. I find the same thing exists in the machines of the Porterville and Mid-California Associations."

Again, on page 183 of the Transcript of Record, Mr. Stebler stated in answer to question at the bottom of said page:

"As I said a while ago on my direct-examination, I didn't have the machines apart enough to explain definitely how they are constructed, but from what I could learn I assume it is a similar construction from what we had in these modified machines I was speaking about in the Riverside Heights Orange Growers' Association."

Complainant's expert witness, Knight, who was also a witness in connection with appeal case No. 2772, wherein was involved the Parker Modified Machine, states, on page 199 of the Record, that the Grading or Sizing Apparatus employed by the appellants herein, is the same as the Parker Modified Machine, his testimony being as follows:

"Q. (By Mr. Lyon): You were familiar, were you, with the so-called Modified Parker Machines in case 1562 as considered by Mr. Lynn Helm, Special Master?

"A. I will have to ask what that machine was.

"Q. In the Riverside Heights Orange Growers' Association?

"A. Yes.

"Q. And examined those machines in connection with counsel and Mr. Lynn Helm?

"A. Yes.

"Q. And gave testimony in regard to them?

"A. Yes.

"Q. Now in regard to the rollers of the Porterville Citrus Association machines and these Modified Parker machines, so-called, were there any material difference so far as function or mode of operation in forming independently adjustable grade openings is concerned over or different from those Modified Parker Machines?

"A. No. No essential difference. There was a difference in construction.

“Q. You mean in details of construction?

“A. Yes.”

It will thus be seen from the testimony of complainant Stebler and his expert witness Knight, that the Grader or Sizing Apparatus employed by the appellants herein, is the same in construction and operation as the Modified Parker Machine, held by Special Master Lynn Helm, to constitute an infringement of the Strain Re-issue Patent, and which report of the Special Master was affirmed by the Judge of the lower court, and which modified sizer this Court held in appeal case No. 2772 not to be an infringement of the said Strain Re-issue Letters Patent. It may be here stated, that complainant Stebler and expert witness Knight, were correct in the testimony which they gave, holding the appellants' Fruit Sizing or Grading Apparatus to be the same in construction and operation as the Parker Modified Fruit Grader or Sizer, the machines having been supplied by Mr. Parker to the appellants herein (record, 119), and comprising a Sizer or Grader composed of two parallel members which formed the fruit runway, one of the said members constituting a fixed member of the runway and the opposing member the rotating wall thereof, and said rotating wall member consisting of a series of longitudinally disposed aligned roller sections, said sections being connected one to the other so as to be driven in unison from power applied to the drive member secured to one end of the forward roller section of the series of

connected sections; differing from the Sizer of the Strain Re-issue Patent by reason of the fact, that its rotary wall member was not composed of a series of independently driven rollers arranged end to end throughout the length of the fruit runway, and each independently driven roller being independently adjustable toward and from the fixed member of the fruit runway so as to independently adjust or vary the outlet apertures for the escape of the fruit to be sized.

The decree of the lower court holding infringement of the Robert Strain Re-issue Letters Patent was prepared by counsel for appellee and signed by the lower court on November 20, 1916, approximately three months prior to the rendition of the decision of this Court in Appeal Case No. 2772, holding the Modified Type of the Parker Grader employed by these appellants not to be an infringement of the Strain Re-issue Letters Patent. However, the lower court did not decide infringement of the Strain Re-issue Letters Patent, but, on the contrary, held non-infringement and the inclusion of these Letters Patent in the decree as prepared by counsel for appellee and submitted to the Court for signing was contrary to said decision. This act of counsel for appellee placed an uncalled for burden on the appellants, requiring an appeal record to be presented to this Court which otherwise would not have been required, thereby placing the appellants to a heavy and unnecessary expense.

We, therefore, respectfully submit that our As-

signment of Error No. 8 is well taken and should be allowed, inasmuch as the Parker Modified Grader was held by this Court, subsequent to the signing of the decree of the lower court in the present appeal cases, not to be an infringement of claims 1 and 10 of the Strain Re-issue Letters Patent No. 12,297.

Out of respect to the lower court, it is only proper to state at this time that counsel for appellants was forwarded by counsel for appellees a long type-written document, with the statement that the same constituted the decision of the lower court. From a reading of this statement, which was duly entitled in the court, the same appeared to be a decision, holding infringement of Claims 1 and 10 of the Strain Re-issue Letters Patent and of Claims 1, 2, 3, 4, 5, 6, 7, 8, 11, 14, 15 and 19 of the Stebler Patent No. 943,799, so that when counsel for complainant, appellees herein, presented to counsel for defendants, appellants herein, a copy of his decree to be submitted to the court for signing, the same appeared to be in conformity with that which he had previously submitted as the decision of the court. After the decree was signed and the appeals perfected to this Court, much to the surprise of counsel for appellants, it was found on an examination of the records, that the only decision rendered by his Honor Judge Trippet, was the decision appearing herein on page 27 of the Transcript of Record, and which decision holds non-infringement of the Strain Re-issue Letters Patent.

After these appeals were perfected, attention of counsel for appellee was directed to the fact that the decree which he had prepared (as he was requested so to do by the decision of the court) and which had been signed by the Judge of the court was at variance with the decision of the court, no effort was made on his part to have correction made, and inasmuch as the cases were then out of the jurisdiction of said court by reason of the perfecting of the appeals, no steps could be taken by counsel for appellants to have the matter resubmitted to the Judge of the lower court.

It may be stated that on the taxation of costs based on said signed interlocutory decree prepared by counsel for complainant, that said counsel secured two-thirds of the cost of the suits by reason of the fact that the decree provided for infringement of two of the Letters Patent out of three involved in suit, one-third of the costs going to defendants. Although counsel for complainant had his attention drawn to the fact that the decree supposedly based on the decision of the court should only have provided a finding of infringement of one of the patents out of three, no offer was made by said counsel to reimburse complainants for the cost which he had secured from them due to the infringement provided in the decree as to Claims 1 and 10 of the Strain Re-issue Patent.

STEBLER PATENT No. 943,799.

(Complainants' Ex. 2, Record p. 516.)

In our opinion, infringement of Claims 1, 2, 3, 5,

appellants' machines not only have identity of results and identity of means, but likewise identity of operation. If any of these requisites necessary to constitute infringement be lacking, there can be no infringement.

For an understanding of the invention of the Stebler patent, it is essential that we appreciate what advance was made by the said invention over the state of the art as it existed prior to the date thereof, and equally so, that we familiarize ourselves with what the inventor gained in results over those produced by the prior patented devices and the devices in use at the time of his invention, and that we understand what improvements he sought to make over the devices in use at such time. For this purpose, and in order that we may fully appreciate what the inventor was seeking to accomplish, we present herewith, a drawing illustrating the Grader or Sizer of the prior art, also a cut disclosing the bin system in use prior to the advent of the Stebler invention, and have added a cut disclosing the embodiment of the Stebler invention in an apparatus utilizing the sizer or grader of the prior art, incorporated with the bin and distributing system of the said art.

Fig. 1 of the drawings represents the sizer or grader of the Robert Strain Re-issue Patent No. 12,297, and which is the grader set forth in the Stebler patent as being the grader employed by him in connection with his invention.

Fig. 2 of the drawings discloses a supporting table,

6, 7, 8, 11, 14, 15 and 19 of the Stebler Patent No. 943,799, was predicated on the results obtained by the appellants' machines, and this, irrespective of the mechanical means employed to produce such results. This Court, in its decision in connection with appeal case No. 2772, (Riverside Heights Orange Growers' Association et al. vs. Stebler, 240 Fed. 703), affirmed the doctrine,

“If a device of a defendant shows a substantial different mode of operation, even though the results of the operation of the machine remains the same, infringement is avoided.”

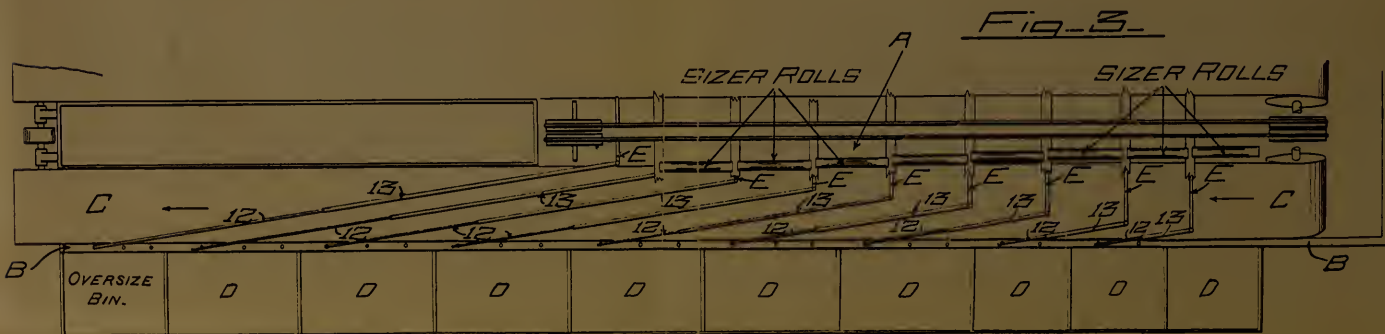
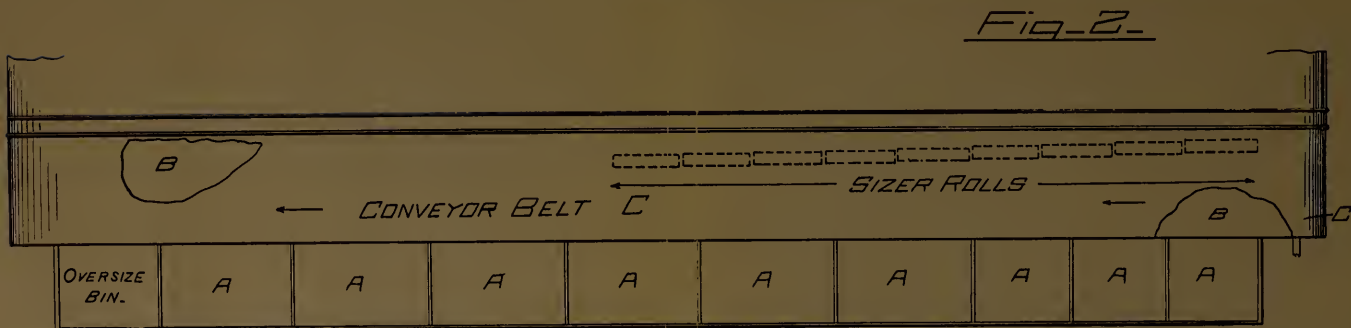
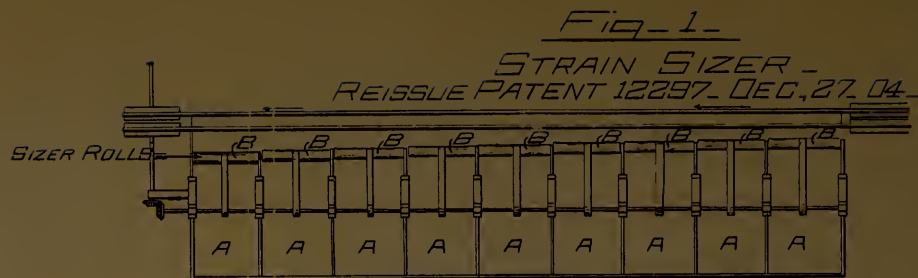
holding the lower court to be in error in its opinion holding infringement, by reason of the fact,

“that the parts of the last mentioned machine operate in substantially the same manner as to produce substantially the same results obtained by defendant's invention, and that, as I understand it, is sufficient to justify, and in fact, requires the Master to make a finding of infringement.”

As stated by His Honor Judge Morrow, in the case of the American Can Company vs. Hickmott Asparagus Canning Company, 137 Fed. 86:

“To sustain a claim of infringement of a patented machine, three things must be found: first, identity of results; second, identity of means; third, identity of operation.”

To hold infringement of the Stebler patent 943,799, it is therefore required that it be found that the



an endless traveling belt, working thereover for propelling the sized fruit, and fruit receiving bins arranged along the side of the table and co-extensive with the length thereof.

Fig. 3 of the drawings illustrates the Robert Strain grader as applied to the frame and bin system of the prior art, having added thereto the distributing chutes of the Stebler invention, and as employed by him for the distribution of the sized fruit from the discharge outlets of the grader to the fruit receiving bins.

The grader or sizer represented by Cut 1 of the drawings, is, as stated, the sizer of the Robert Strain Re-issue Patent No. 12,297, Complainants' Exhibit 1, and it will be noted by reference thereto, that the fruit receiving bins A, are extended the entire length of the apparatus or substantially co-extensive with the length of the end to end rollers B, which constitute the rotary wall member of the fruit runway for the grader. Usually, the apparatus is constructed with nine independently rotatable rollers B, each roller being adjusted to provide with the opposing wall member of the fruit runway a grade outlet of a given area for the escape there-through of fruit to be sized, these rollers being so adjusted as to provide a progressively stepped rotary wall member for the fruit runway, so that there are provided nine outlets, each differing in size, and where nine sizing rollers are employed there is provided nine bins B, a bin for each roller to receive the fruit sized thereby and discharging

from the outlet thereof. This grader as placed on the market and shown by the record herein, varied in length from nine to fifteen feet.

Cut 2, of the sheet of drawings, represents the supporting table and the endless traveling belt and the fruit receiving bins of the Thomas Strain Patent No. 775,015, defendant's Exhibit 3, record page 525. We have removed from the apparatus the grading elements and likewise the distributing elements for the sized fruit, and which elements control the flow thereof into the bins. The length of this table as the machine was constructed and placed into operation, as we shall hereinafter show by the record, was between thirty and forty feet in length, and the fruit receiving bins A, arranged alongside the supporting table B, over which travels the longitudinally movable belt C, were so disposed as to be extended the entire length of the table B. There were nine fruit receiving bins provided, which were adapted to receive the nine sizes of fruit from the discharge outlets of the sizing element of the machine.

What the appellant Stebler sought to accomplish by his invention, was, to utilize a short grader (Cut 1) in conjunction with a long table, with the fruit receiving bins arranged along the side thereof and extended for the full length of the said table (Cut 2), but it was obvious that when the sizer illustrated by Cut 1 was applied to the table and bin construction of the Thomas Strain Patent No. 775,015 of Nov. 15, 1904, (Cut 2), and which was be-

tween thirty and forty feet in length, approximately one-half of the length of the table and of the bins would be extended or projected beyond the end of the sizer. This is apparent by reference to Figs. 2 and 3 of the drawings, wherein the said sizer rollers of Fig. 1 of the drawings are illustrated as applied to the table and bin construction of the Thomas Strain Patent No. 775,015. It is here that the Stebler invention came into existence, which invention resided in providing means whereby the sized fruit would be directed transversely of the longitudinally traveling belt and guided thereby into the bin arranged for the reception of such sized fruit, and such provision had to be of such a character as to lead approximately one-half of the sized fruit to fruit receiving bins extended a distance beyond the end of the sizer. These guide means for directing the travel of the sized fruit at a transverse inclination to the travel of the longitudinally movable belt, we find, by reference to the Stebler Patent No. 943,799, (record page 516), to be of such a character as to provide downwardly inclined chutes or runways. In Fig. 3 of the drawings presented herein, the sizer is designated by the reference letter A, the supporting frame or table, by the reference letter B, and the endless longitudinally traveling belt is designated by the letter C, and the fruit receiving bins by the letter D. The guides which form the chutes or runways for directing the sized fruit at a downward inclination from the discharge outlets of the sizer to the fruit bins and transversely of the longitudinal belt, are designated by the refer-

ence numeral 13. Inasmuch as it was desirable at times to shift the position of the guides 13 relative to the fruit receiving bins, each of the said guides at or adjacent to the discharge outlets of the roller members of the sizing apparatus were pivotally secured to projecting studs E, so as to permit of the same being swung or moved at an oblique angle to the longitudinally traveling belt, and in order that these guides might be extended or elongated, each guide was made in two sections, the outer section 12, telescoping within the inner pivotal section 13. Under this arrangement, it was possible to carry the fruit a distance from the sizing rollers of the sizer or grader, and more particularly as to the sized fruit to be deposited into the last four or five bins of the apparatus extended a distance beyond the longitudinal terminal extension of the sizer or grading element, the last of the series of bins being approximately fifteen or twenty feet beyond the end of the grader. By this arrangement, a short sizer could be employed in connection with bins of considerable width, and the fruit properly distributed within the bins and to the bins situated at a distance from the terminal end of the grader or sizer by means of the swinging and telescopic guides 13.

We thus see, that the Stebler invention, that is, the distributing means, of the Stebler patent, resides in a construction of guiding means disposed to lead the sized fruit transversely of the longitudinally movable belt, and of such a construction as to guide the fruit from the discharge outlets of the

sizer to bins situated at a point remote from the sizer or grader.

His contribution to the art, therefore, resides in the provision whereby the supporting and distributing means shall have a longitudinal extension greater than the longitudinal extension of the sizer or grader employed in connection therewith, and in the guiding means employed being of such a construction or arrangement as to lead the sized fruit from the sizing outlets transversely of the longitudinally movable belt to the delivery point for the fruit within the bins.

That such is the case, it is only necessary to refer to the specification of the Stebler patent, wherein we find the statement made as to one of the objects of the invention:

“Is to provide a suitable distributing apparatus in connection with a short or small grader or sizer, thus enabling the use of a short sizer or grader and still deliver the separated or sized fruit in bins of such width as to provide easy access thereto for the packers.”

(Lines 19-25, page 1, printed specification.)

Again,

“Heretofore it has been necessary either to provide a very large or long fruit grader or sizer, so as to conduct the several grades of fruit some distance along the grader before being discharged into the bins, or to utilize smaller bins. With this invention it is possible to use a relatively short grader or sizer, and utilize a distributing conveyor, and to carry

the separated and sized fruit to bins of the desired width extended much beyond the length of the grader and arranged at the sides of the conveyor.”

(Lines 38-49, page 1 of the printed specification.)

We are further informed by the specification, that,

“the invention consists in the provision, in connection with a fruit sizer or grader, such, for example, as the ‘California Grader’ of Letters Patent of the United States to James Ish, No. 453,422, dated Aug. 25, 1891.”

(Lines 53-58, page 1 of the printed specification.)

This Ish patent appears in the record as defendant’s Exhibit F, (record page 770), and is substantially the same as to length and sizing operation as the sizer or grader of the Strain Re-issue Letters Patent.

It will be noted by a reference to Figs. 1 and 2 of the drawings of the Stebler patent 943,799, (Complainants’ Ex. 2), that the last four bins of the series of bins are extended quite a distance beyond the end of the sizer or grader. These bins are formed by placing adjustable partition pieces 17 within a bin frame, which frame is extended the entire length of the supporting frame of the apparatus.

It is difficult to read the Stebler patent and gain therefrom any knowledge other than it is the intent

and purpose of the inventor of the device disclosed thereby, to provide for the utilization of a comparatively short grader with a comparatively long supporting frame, extended a distance beyond the terminal end of the grader or sizer, so that, with a grader, say fifteen feet in length, there may be utilized a series of fruit receiving bins thirty or forty feet in length, thereby securing a large bin for each size of the fruit to be delivered from the discharge outlets of the sizer or grader, and in making provision whereby the sized fruit shall be guided transversely of the longitudinally movable belt, from the sizing outlets of the sizer or grader to the bins for the reception of such fruit.

With the sizer or grader of the Strain Re-issue Patent (Complainants' Ex. 1), fifteen feet in length and nine sizing rollers incorporated therein, each sizing roller would be approximately one and one-half feet in length; consequently, with nine bins employed in connection therewith and it is necessary that a fruit receiving bin be employed for each sizing roller and the bins not being extended beyond the length of the sizer, there would be nine bins each of approximately a foot and a half in length. By the Stebler invention, with a sizer or grader fifteen feet in length, the supporting frame therefor may be of thirty or forty feet in length, and where forty feet in length and nine bins provided, each bin would be of approximately four and one-half feet in width; but it is obvious, that the fruit from the sizing rollers could not be delivered to the said fruit receiving bins extended beyond the end of the

grader unless means be employed to lead the sized fruit from the sizing rollers to such bins, and such means necessarily must be extended from the discharge outlets and arranged in such a manner as to be disposed transversely of the longitudinally movable belt.

PRIOR ART.

Letters Patent No. 741,928, granted Rayburn, October 20, 1903, Apparatus for Sorting and Distributing Fruit.

Letters Patent No. 775,015, granted Thomas Strain, Nov. 15, 1904, FRUIT GRADER.

Letters Patent No. 906,605, granted Beekhuis, Dec. 15, 1908, FRUIT GRADER.

Camel-back Machine, Defendant's Photo Ex. O, P and P¹, record pages 815, 817 and 819.

These devices will be considered for the purpose of ascertaining what invention was produced by patentee Stebler at the time of his entry into the field as an inventor, for it is our position that it was old in the art and well known at such time to provide a sizing apparatus with distributing means for the guiding or directing the sized fruit to fruit receiving bins extended beyond the length of the sizer proper.

Camel-back Machine.

One such form of apparatus is illustrated by Defendant's photo Ex. O, (record p. 815), and from an

inspection of which. it will be noted, that the Ish or California sizer, is employed for the sizing of the fruit, the fruit flowing from the discharge outlets for the sized fruit and being by transversely disposed chutes guided to the bins for the reception of the fruit, said guides or chutes conveying sized fruit to certain of the bins extended a distance beyond the end of the sizing roll of the sizing member.

Another such apparatus is disclosed by defendant's Exhibits P and P¹, (record pp. 817-819), which illustrated fruit sizers having associated therewith fruit receiving bins extended a distance beyond the length of the sizer or grader, the sized fruit being conveyed by downwardly and transversely inclined chutes or guides into the bins adapted to receive the same, these chutes or bins being provided with means whereby the fruit may be deflected from one chute or runway into another. These exhibits will be referred to later by reference to the testimony, as they illustrate devices in use a great many years prior to the invention of patentee Stebler.

There was also in use in the State of California long prior to the invention set forth in the Stebler patent, a device known as the Rayburn sizer. This device is covered by United States Letters Patent No. 741,928, of October 20, 1903, for an improvement apparatus for sorting and distributing fruit, the same appearing in the record as defendant's Exhibit "J," (record page 791).

RAYBURN PATENT, No. 741,928.

This patented apparatus discloses the usual type of California sizing or grading device, represented in the drawings by the letter A. Beneath the grader and at each side thereof, is arranged a series of fruit receiving bins 5, the sized fruit being conducted from the outlets of the sizing apparatus of the grader or sizing element by means of the downwardly inclined chutes or troughs 3, which troughs in turn discharge the fruit into a continuation thereof, designated by the reference numeral 4, arranged to extend at substantially right angles to its associated member 3 and to deliver the sized fruit into the respective bins. A glance at the drawings discloses that certain of the bins situated at the sides of the machine are extended a distance beyond the terminal end of the fruit sizer or grader. For this apparatus a longitudinally traveling belt was not utilized, but the apparatus did employ a sizer or grader of the same type and character as that shown and described in the Stebler patent, and the letters patent therefor do disclose fruit receiving bins situated at each side of the apparatus and extended to a distance beyond the terminal point of the sizer or grader and in connection therewith chutes or guides for directing the fruit from the sizing outlets of the grader and guiding the same to the respective bins for the reception thereof, and like the patent in suit, the Rayburn device had for its object,

“To provide suitable means for the rapid handling of the assorted fruit by affording

accommodation for a greater number of packers than it has heretofore been generally possible to employ * * *.”

Like the Strain invention, the Rayburn invention provided for increasing the width of the bins in order that a greater number of packers could be accommodated, than was before possible where the bins were of a small area.

It was not new in the art, at the date of the Stebler invention, to provide bins arranged along the side of a supporting structure having a length approximately thirty or forty feet, for such arrangement is disclosed in Letters Patent No. 775,015, granted Thomas Strain, November 15, 1904, (record page 525), and which Letters Patent issued approximately five years prior to the issuance of the Stebler patent, while the Rayburn patent issued approximately six years prior to the Stebler patent.

In the Strain patented device, there is provided an endless longitudinally traveling belt 10, which is disclosed in Figs. 2, 6, 7, and 9 of the drawings of said Letters Patent, and associated therewith means forming chutes or guides for directing the travel of the sized fruit transversely of the longitudinally traveling belt and delivering the same at any suitable point within the bin designed for the reception thereof.

STRAIN PATENT No. 775,015.

(Record page 525.)

In order to better appreciate the bearing which these Letters Patent have as to limiting the scope

claimed for the invention of the Stebler Patent No. 943,799, it is deemed advisable to give a more detailed analysis of the invention of the said Thomas Strain, as disclosed by Letters Patent No. 775,015.

We find the apparatus therein disclosed to be for a fruit grader, and the embodiment of the invention, as therein disclosed, is a fruit grader having a fruit runway, formed of two parallel members, one member thereof constituting the rotary grading element of the apparatus, and which grading element is designated by the reference numeral 20 in the drawings of the Letters Patent, and is more clearly shown by reference to Figs. 3, 4, 5, 7 and 9 of said drawings. Beneath this member and extended to one side thereof is arranged a longitudinally traveling conveyor belt or carrier 10, onto which the sized fruit escaping from the discharge outlets of the grader moves by gravity, the said carrier moving longitudinally over the downwardly inclined sections of the supporting bed of the apparatus. Alongside of the downwardly inclined bed portion of the apparatus, is situated a series of longitudinally disposed fruit receiving bins into which the sized fruit is received, these bins being co-extensive with the length of the grading apparatus. The sized fruit, unless otherwise obstructed, flows by gravity from the outlet aperture for the sized fruit, transversely of the longitudinally traveling belt or conveyor into the bins located for the reception thereof. However, there is associated with the longitudinally traveling carrier of the said apparatus a plurality of barriers or arresting mem-

bers 36, which are arranged parallel with the endless traveling belt or carrier 10, and associated with each of said barrier members 36 is a longitudinally adjustable barrier member 36-B. These two members co-acting form a chute or runway, the member 36 serving to arrest the downward gravity flow travel of the sized fruit transverse of the carrier and change its direction of travel to a direction parallel with the endless moving carrier belt 10, the associated longitudinally disposed adjustable barrier member 36-B serving the purpose of deflecting the fruit from the traveling belt or carrier into the bins at any desired point throughout the length thereof. Inasmuch as these co-acting members 36 and 36-B are arranged longitudinally of the grading apparatus and parallel with the endless traveling belt or carrier 10, they form throughout the length of the apparatus a series of chutes for guiding the sized fruit and directing the same to any desired discharge point relative to the fruit receiving bins. With the Thomas Strain apparatus, it is the members 36 with its associated longitudinally adjustable members 36-A which form the chutes for directing the sized fruit relative to any particular or desired portion of the fruit receiving bins.

The Letters Patent granted to Tom Strain illustrates and describes every feature of the invention of the Stebler patent for the distributing system, if the claims thereof are to be construed to mean other than the specifically constructed devices disclosed by the drawings and described in specification thereof, with this exception, that in the Strain

patent, the partition pieces of the bins are not longitudinally adjustable; but bins with adjustable partition pieces were old in the art, and used in combination with chutes for conveying the fruit from the discharge outlets of the sizing apparatus to the said bins, such being fully disclosed by defendant's Photo Exhibits O, P and P¹, (record pp. 815 to 819), illustrative of the Camel-back sizing apparatus in public use many years prior to the invention of patentee Stebler^d and no function results from the use of the adjustable bins of the said Stebler patent differing in any manner from that of the adjustable bins of the said prior art.

The only distinction that can be drawn between the device of the Thomas Strain Patent No. 775,015 and the invention disclosed by the Stebler Patent 943,799, must and can only be found to reside in the use of the particularly constructed and disposed guide chutes of the Stebler invention, by means of which it is possible to utilize a short sizer or grader, instead of the long sizer or grader of the Thomas Strain Patent 775,015; or, in other words, to substitute for the grader or sizing element of the Thomas Strain patent, the short grader or sizer of the prior art, viz, the California sizer of the Ish Patent No. 458,422, (record p. 770); the sizer of the Robert Strain Re-issue Letters Patent No. 12,297, or the Rayburn Patent No. 741,928, (record p. 791), but such only can be accomplished by resorting to the peculiarly constructed guides or chutes which are disclosed in the Stebler Patent No. 775,015 and which form of guides or chutes differing

from the guides or chutes of the Thomas Strain patent by being arranged at a transverse inclination relative to the longitudinally traveling belt for the sized fruit. In the Thomas Strain patent the means which control the discharge of the fruit relative to any given position of the fruit receiving bins, is the longitudinally adjustable member 36-B, which co-operates with its associated member 36, to form a guide chute. The member 36 is a fixed barrier arranged to arrest the downward gravity flow of the fruit from the sizing outlets of the grader or sizer toward the fruit receiving bins, while the associated member 36-B serves to act as a longitudinally adjustable barrier for controlling the discharge point of the sized fruit from the longitudinally movable carrier relative to the fruit receiving bins. The purpose of such longitudinally adjustable barriers being to evenly distribute the fruit within the bins, the patentee Strain stating in this connection, as to one of the objects of the invention:

“My invention is to provide means whereby the fruit will be thoroughly mixed or delivered into each bin in such a way that the several sizes of fruit in each bin are perfectly distributed. This is a valuable feature, for the reason that although the average size of fruit in different bins vary, still the actual size of fruit delivered into each bin will also vary somewhat.”

(Lines 13-31, page 1 of the specification.)

Again,

“The deflector 36-B is provided with a lug

36-C, and the latter is adjustably mounted on the bracket 36-A and clamped thereto by means of a set screw 36-D. The deflector 36-B may be placed at any desired point in the bracket 36-A, so that the fruit will be shunted into the bin at any desired point. This allows the fruit to be delivered into the bin in such a way that it is thoroughly mixed. If the fruit were delivered into the bin directly from under the grading rods, the size of the fruit in the bin at one extreme side would be larger than the size at the other side. To obviate this difficulty, I employ the guards 36 and deflector 36-B, by means of which the fruit is thoroughly mixed in the bin, and no particular size occupies a particular place in the bin, as would be the case were the guards and deflectors not employed."

(Lines 65-85, page 2 of the specification.)

By means of these longitudinally adjustable deflectors or barriers, the point of discharge for the sized fruit relative to the bins is under the absolute control of the operator, so that the fruit is not only evenly distributed within the bins, but, equally so, the fruit is prevented from pyramiding at any portion of the bin. However, the longitudinally adjustable barrier or deflector 36-B does not direct and control the movement of the sized fruit from the outlet opening of the sizer to the bin and transversely of the longitudinally movable carrier, as is the case with the guide chutes of the Stebler patent 775,015, and it is in this respect that the Stebler invention differs from the Strain invention, as, by such a construction and arrangement of the guide chutes, patentee Stebler is enabled to extend the

fruit receiving bins for a distance beyond the terminal point of the fruit sizer or grader; whereas, in the Thomas Strain patent, the fruit receiving bins, in length, is substantially co-extensive with the length of the grader or sizer.

There is no question and can be no question but what in appellee's device as constructed and placed into operation in accordance with the disclosure of the Stebler patent 943,799, the grader is a comparatively short one relative to the length of the bins, for this, we are told by his testimony, (page 169), which is:

“Q. In the device disclosed by Complainant's Exhibit No. 2, the grader is comparatively short grader, is it not?

“A. Well, you might consider it so. I don't know as I should; we make a practice of making the grader shorter than the bins; no established rule in regard to that.

“Q. What is the usual length and proportion of the grader relative to the length of the bins as installed by you, Mr. Stebler?

“A. Well, with us, I suppose the most common difference in length there would be the bins probably 10 feet longer than the grader, or 12 feet.”

It will thus be noted from the testimony of Appellee Stebler that the length of the bins is at least ten or twelve feet longer than the grader, and accepting the usual length of the grader as not being over 15 feet, which is the accepted rule, then the length of the bins would be 25 or 27 feet.

Witness Milligan, (record page 304), states, in response to question appearing on page 303, as to how the length of the grader member compared with the length of the bins for receiving the fruit:

“I couldn’t give you the exact proportion of the distance, but approximately it is about half way, or a trifle over half way of the bin surface.”

The testimony of the witness is supported or upheld by the drawings of the Letters Patent 943,799, wherein in Figs. 1 and 2, the grading member or sizer is illustrated as approximately a fraction over one-half the length of the bins.

There can be no question but what the longitudinally adjustable members 36-B of the Thomas Strain Patent No. 775,015 were utilized and designated for the purpose of varying the point of discharge of the fruit relative to the fruit receiving bins, for such is testified to by Witness Thomas Strain, Jr., by the following testimony (record pages 320-322):

“Q. What means, if any, were employed in the said machine for controlling the distribution of the sized fruit relative to the fruit receiving bins?

“A. There was small pieces of wood about 1 by 2, with * * * an angling piece to draw the fruit off the belt, and that was adjustable, could be moved from one part of the bin to another to evenly fill the bins.

“Q. Was that adjustable longitudinally?

“A. Longitudinally.

“Q. What was the purpose of that adjustable piece?

“A. It was to fill the bins evenly, and to distribute the fruit from one part of the bin to another.

“Q. Can you say whether or not it would serve to prevent the fruit pyramiding in the bin?

“A. It would not prevent it from pyramiding it in the bin, but when you did get one pyramid, you could move this and fill the vacant part of the bin, and in that way get your bins filled all over.

“Q. That is, it would even up the distribution of the fruit within the bins?

“A. Yes.

“Q. Could you, or could you not, by said means vary the distribution of the fruit from one bin to an adjacent bin?

“A. You could.

“Q. How was that variation made?

“A. By moving this apparatus that took the fruit off the edge of the belt along to some other point in the bin, or to the next bin.

“Q. With the letters patent before you, and directing your attention more particularly to figures 6 and 11, and also figure 3 of the said letters patent, can you point out the part which you have referred to, and by means of which you state the distribution of the fruit could be varied relative to the bin?

“A. I will have to get this thing around so I will know what end of it I have.

“Q. (By the Court): What is it that causes

the fruit to be distributed in the bins shown in the picture or drawing?

“A. I don’t know these are by numbers, but it is this little apparatus on the side here. It is right here (indicating to the Court).

“Q. This one? (indicating)

“A. Yes; this right here is movable (indicating).

“Q. (By Mr. Acker): You mean this part marked 36-A?

“The Court: What Exhibit have you got?

“Mr. Acker: The Thomas Strain, Complainant’s Exhibit Number 3. You will find it in figure 11 of the drawing, 36-A.

“Mr. Lyon: I would suggest you allow the witness to tell us this thing. There is the part 36, and the part 36-B, and let him pick it out, as to what it is. Let us see if he knows anything about it.

“A. In this drawing here, I would say 36-B—is that B or A—that is B here.

“The Court: That is B.

“A. 36-B.

“Q. (By Mr. Acker): That piece, I understand you to say, was longitudinally adjustable relative to the traveling belt?

“A. It was.

“Q. And I understand you to say that is the piece which you refer to in your testimony as directing the point of discharge of the fruit relative to the bins?

“A. Yes.”

To the same effect is the testimony of patentee Thomas Strain, Sr., (record pp. 423-24):

“Q. (By Mr. Acker): Approximately what was the length of that machine?

“A. About 38 or 40 feet; we called it a 40-foot grader.

“Q. And what is the length of the bins for receiving the fruit in comparison with the length of the apparatus?

“A. Same length practically.

“Q. Please state how the discharge of the fruit, the sized fruit, relative to the fruit-receiving bins was controlled.

“A. The fruit fell on the flexible grader which was adjusted for the sizing of the fruit, the flexible shafting for adjusting the sizing of the fruit, and when the fruit rolled through that, the belt was continued down about 10 inches lower and the fruit would be rolled into the bin, but there was a projection to stop the fruit in that direction, and the fruit was carried around that until we wanted to switch it off, and there were little switches on each side to throw the fruit into any bin we wanted.

“Q. Were those switches stationary?

“A. No; they were not stationary.

“Q. What was the purpose of those switches?

“A. To fill the bin to any length. The first part of the bin would fill up, and then the switch would throw them over, and you could switch the fruit anywhere you wanted to make it—mix the fruit.

“Q. That is, to get an even distribution into the bin?

“A. When the bin would fill up at one end, you could switch it off and get to the other part of the bin.

“Q. Those switches, I understood you to state, were movable?

“A. Yes; movable.

“Q. And in what direction were they movable relative to the travel of the belt?

“A. The same way as the belt, longitudinally.

“Q. And they were longitudinally adjustable?

“A. Yes.

“Q. And if I varied the position of these devices and adjust them longitudinally, what effect would it have relative to the discharge of the fruit into the bins?

“A. It varies the point of discharge?

“A. Yes.”

We particularly direct attention to this testimony, for the reason that the function given for the member 36-B of the Thomas Strain patent, is the function and only function, of the longitudinally adjustable barriers of the appellants' machine.

BECKHUIS PATENT.

Record p. 99.)

These letters patent disclose a fruit grader having in combination therewith a belt distributing system for delivering the sized fruit a distance from the grader. The apparatus we learn from the specification of the Letters Patent is designed for use

in canning plants. It comprises a grading table 3, for the fruit to be graded, such being one well-known form of a fruit grader, said table being provided with a series of outlet or discharge holes 6, arranged in groups, the outlets in successive groups, being graduated in size. Beneath each group is located a chute 7, which leads the sized fruit onto a longitudinally movable traveling carrier 8, best seen in Fig. 1 of the drawings, arranged parallel of the grader. Associated with said traveling carrier 8 is a series of pivoted barriers 11, extended transversely of the carrier 8, which barriers 11 guide or lead the sized fruit from off the carrier onto the members 12, located to receive such sized fruit, each member 12 being designed to receive a different size of fruit. The members 12 may comprise fruit receiving bins, but in the patent they are disclosed as traveling carriers for leading the sized fruit to canning tables situated at a distance from the grader or sizing apparatus.

It will be noted that certain of the members 11 and 12, are extended beyond the grader or sizer, and that the endless traveling carrier 8 is extended beyond the grader.

The apparatus of the Letters Patent has in common with the Stebler apparatus, a grader or sizer, a longitudinally traveling carrier parallel with the grader or sizer and extended beyond the end thereof, and there is associated with the said carrier a series of pivoted transversely disposed guides for directing the sized fruit from the carrier onto the members to receive the same.

Thus in the prior art, we have the Camel-back Machine, Defendant's Photo Ex. O (Record p. 815), testified to by witness Ofstad to have been in public use as early as 1906, (Record p. 389), and the same machines, Defendant's Exhibit P and P¹, (Record pp. 817-819), testified to by witness Sifford to have been in public use as early as the year 1904, (Record p. 433.)

In the Camel-back Machines of the prior art we have the California sizer (same as disclosed in the Stebler patent), the fruit receiving bins extended beyond the sizer, the bins having adjustable partitions for increasing or decreasing the width of the bins. The bins are of large capacity to accommodate a number of packers, and the sized fruit is directed from the discharge outlets of the sizer to the respective bins by means of inclined transversely disposed guide chutes. The fruit bins were capable of being increased or decreased as to width by means of the adjustable transverse partition pieces or boards, which are the means employed by patentee Stebler for increasing or decreasing the width of the fruit receiving bins. As to this adjustability witness Ofstad testified, (Record pp. 391-2), as follows:

“Q. And you thereby increase or decrease the width of the bin or the length of the bin?

“A. Yes.

“Q. Please state whether or not the guide strips appearing in the said photo exhibit and which form the fruit runways for conveying

the fruit from the grading outlets to the bins are movable or stationary strips?

“A. I would have to see the photographs. (Receiving photographs from the court.) Well, in this particular machine, I am not positive whether it was movable or stationary. I have seen machines where they were—in our own house at Riverside that were stationary, and then again in houses I have seen where they were hinged so as to be movable.

“Q. And when and where were those machines used?

“A. I think the house up in Porterville, I saw the—that is the first one I saw.

“Q. What advantage, if any, flowed from the use in the said apparatus represented by the said photograph of the partitions for the bins being adjustable or removable to increase or decrease the length of the bin?

“Mr. Lyon: That is objected to on the ground it is assuming that it does not appear from the evidence if there was any such adjustability.

“Mr. Acker: I understood the witness to so testify.

“Mr. Lyon: The witness says he thinks perhaps they were; he did not say positively they were.

“The Court: Objection overruled.

“A. Read the question; I didn't understand it.

“(Last question read by the reporter.)

“A. What advantage has the—if I understand, the question is, what advantage the

packing-house received by having these boards detachable.

“Q. (By Mr. Acker.) Yes; of the bins; the transverse partition pieces in the bins.

“Q. (By the Court.) The partition pieces in the bins. Why do you want to move them?

“A. So as to get greater capacity so we can get more packers at it and get a greater volume of fruit.

“Q. (By Mr. Acker.) What was the advantage obtained in connection with the devices used by the defendants in the present suit in having the transverse partitions of the bins longitudinally adjustable.

“A. Why, to give us capacity, so we can get packers and increase the volume—output per day.

“Q. And did that differ in any manner from the provision for the adjustability of the bins in the device of the Upland sizer?

“A. No, sir.”

Next in order of time comes the Rayburn Sorting and Distributing Apparatus. Defendant's Exhibit “J” (Record p. 791). Here the fruit receiving bins are situated at each side of the machine and extended beyond the end of the fruit sizer, the sized fruit being directed to the respective fruit bins by downwardly inclined chutes. Neither the Camel-back machines nor the Rayburn machines were provided with a longitudinal movable carrier onto which the sized fruit discharged.

The Rayburn patented device was followed by the Thomas Strain apparatus, of Letters Patent No.

775,015, (Record p. 528). In the apparatus, the sizing or grading element was from 30 to 40 feet in length, differing in this respect from the comparative short sizer or grader of the Camel-back and Rayburn apparatus. The long guide chutes of the Rayburn machines were dispensed with in the Thomas Strain apparatus, and a longitudinally movable carrier disposed parallel of and which extended substantially the full length of the sizer or grader was employed. Alongside of the said conveyor or carrier a series of fruit receiving bins were disposed, the same extending the full length thereof. A series of longitudinally movable barriers we find associated with the longitudinally movable carrier in order to regulate the point of discharge for the sized fruit relative to the fruit receiving bins, in order to secure an even distribution of the fruit within the bins and prevent the pyramiding thereof.

The Beckhuis device of Letters Patent No. 906,605, followed the Thomas Strain patent, and patentee Beckhuis substituted for the longitudinally movable barrier 36-B of the Thomas Strain patent, a series of pivotally mounted barriers 11, transversely disposed relatively to the endless traveling carrier 8, and by means of which the sized fruit is guided from the longitudinally movable carrier onto members for the reception thereof.

It will thus be noted that when appellee Stebler conceived the invention of Letters Patent No. 943,799, he came into a well-filled field, and, therefore, such invention as may be displayed thereby must be of a limited character, not in any sense a generic invention.

There are no generic features disclosed by the Letters Patent, and the only feature which distinguishes the apparatus from the disclosure of the Thomas Strain Patent No. 775,015, resides in the employment of the pivoted transversely disposed guide chutes *in lieu* of the longitudinally adjustable barriers 36-B of the said Strain patent, and by the use of which transversely disposed telescopic guides or chutes, the patentee made it possible to utilize a comparatively short sizing apparatus in conjunction with a longitudinally movable carrier and fruit receiving bins extended a distance beyond the discharge end of the sizer; in other words, to substitute for the 30 or 40 foot sizer of the Thomas Strain patent the short 9 or 15 foot sizer of the Ish patent or the Robert Strain re-issue patent, and by so doing installing a comparatively short and inexpensive sizer for the long sizer, thereby reducing the cost of installation without sacrificing the benefit resulting from the use of the longitudinally movable carrier and the wide fruit receiving bins of the Thomas Strain patent and the wide bins of the Rayburn inventions and as previously used, the adjustable bins of the Camel-back sizer.

FILE-WRAPPER OF THE STEBLER
PATENT No. 943,799.

So far we have treated the Stebler invention from the face of the Letters Patent, and in such light compared the same with the prior art. However,

when viewed in the light of the proceeding which took place in the Patent Office during the course of the prosecution of the application which eventuated in the grant of said Letters Patent and understand the limitations placed thereon during such prosecution, which cannot be ignored at this time, the only conclusion which one can reach is that the invention is of an exceedingly limited character.

As stated by the Circuit Court of Appeals, for the Sixth District:

“It is the broad, general rule that where the Patent Office rejects a claim covering a device on its merits, and the rejection is acquiesced in and the patent issues, the applicant cannot afterwards be permitted a construction of the claims allowed wide enough to embrace the claim which was rejected. *Morgan Envelope Co. vs. Albany Paper Co.*, 152 U. S. 425, 429, 14 Sup. Ct. 627, 38 L. Ed. 500; *Royer vs. Coupe*, 146 U. S. 524, 532, 13 Sup. Ct. 166, 36 L. Ed. 1073; *Thomas vs. Spring Co.* (C. C. A. 6), 77 Fed. 420, 430, 23 C. C. A. 211. Thus, where the applicant, in order to get his patent allowed, is compelled to accept a claim narrower than contained in his original application, such claim cannot be construed to cover what was rejected by the Patent Office. *Hubbell vs. United States*, 179 United States 77, 80, 21 Sup. Ct. 24, 45 L. Ed. 95; *Campbell vs. Amer. Shipbuilding Co.* (C. C. A. 6), 179 Fed. 498, 502, 103 C. C. A. 122, and cases there cited.”

Frey vs. Marvel Auto Supply Co., 236 Fed., p. 921.

Also by the Circuit Court of Appeals, for the Eighth Circuit:

“It is settled that, when an applicant for a patent inserts limitations and restrictions to comply with rulings of the Patent Office, he cannot afterwards have constructions of his patent as though the limitations and restrictions were not contained in it. *Computing Scale Co. vs. Automatic Scale Co.*, 204 U. S. 609, 27 Sup. Ct. 307, 51 L. Ed. 645; *Royer vs. Coupe*, 146 U. S. 524, 13 Sup. Ct. 166, 36 L. Ed. 1073; *Phoenix Caster Co. vs. Spiegel*, 133 U. S. 360, 10 Sup. Ct. 409, 33 L. Ed. 663; *Cotto-Waxo Chemical Co. vs. Perolin Co.*, 107 C. C. A. 373, 185 Fed. 267.”

(*Moon-Hopkins Billing M. Co. vs. Dalton A. M. Co.*, 236 Fed. 921.)

As said by the Circuit Court of Appeals for the Sixth Circuit, in *Dowagiac Mfg. Co. vs. Superior Co.*, 115 Fed. 886, at end of page 896:

“Whatever doubt there might have been as to whether the claim was limited to the construction of its language by the specification, *it was removed by the limitation which he put upon it by his explanation*, the consequence of which was the allowance of his patent, *and the claim must be read as limited in this respect* in the same way as are the other claims.”

“A claim must be construed as limited by amendment and acquiescence in the Patent Office.”

Peifer vs. Brown, 112 Fed. 435.

And as said by the court in *Kelly vs. Clow*, 98 Fed. 297, a Circuit Court of Appeals case:

“He cannot claim such a construction of his patent as would include what he was expressly

required to abandon as a condition of the grant, even if it takes away a material part of his real invention.”

And as said by the court in *Sutter vs. Robinson*, 119 U. S. 530:

“Complainant is not now at liberty to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant.”

And as said by the Supreme Court in *Roemer vs. Peddie*, 132 U. S. 313:

“This court has often held that ‘When a patentee, on the rejection of his application, inserts in his specification, in consequence, limitations and restrictions for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as if would have been construed if such limitations and restrictions were not contained in it.’ ”

The Patent Office file wrapper proceedings of the application of the Stebler patent appears between Record pp. 572 to 617.

As originally filed the application contained the following five claims (Record pp. 580-1):

1. A distributing apparatus comprising a horizontally traveling conveyor, and guiding means arranged along the conveyor forming chutes to guide the fruit to the portion of the bin desired.

2. A distributing apparatus comprising a horizontally traveling conveyor arranged below a grad-

ing element, the conveyor being inclined downwardly away from such grading element, bins arranged below and along said conveyor, and guiding means arranged along the conveyor and providing chutes for directing the fruit to the bins.

3. A distributing apparatus comprising in combination with a grading element, a horizontally traveling conveyor inclined downward away from said grading element, adjustable guiding means arranged along the conveyor and forming chutes for the discharged fruit, a distributing apparatus adapted for use with a grading machine and comprising a horizontally traveling conveyor arranged below the grading machine to receive the graded fruit therefrom, and adjustable means arranged along the conveyor and forming chutes for directing the separated fruit to the point of discharge from said conveyor.

4. In combination, in a distributing apparatus adapted for use in connection with a fruit grader or sizer and fruit receiving bins, of a horizontally traveling conveyor, a pulley or sheave for said conveyor mounted on an inclined axis and working in conjunction with a second pulley or sheave mounted upon a horizontal axis, a hip over which the conveyor travels as it approaches said horizontally mounted sheave, and guiding means arranged along the conveyor and forming chutes for the fruit.

5. A fruit distributing apparatus adapted for use with a fruit grader or sizer and comprising a horizontally traveling conveyor, adjustable fruit

bins arranged below said conveyor, and adjustable guiding means arranged along the conveyor and forming adjustable chutes for guiding the sized fruit from said grader to said bins.

Claims 1 and 2 of the said series of claims constituted generic claims and had they been allowable a device constructed in accordance with the Thomas Strain Letters Patent No. 775,015, or in accordance with the Beckhuis Patent No. 906,605, would have constituted an infringement thereof. However, said claims were properly rejected on reference to prior Letters Patent, which rejection was acquiesced in by the applicant, and said claims, together with claims 3, 4 and 5, were cancelled and a new series of claims, 13 in number, inserted, and the specification amended by adding thereto the following matter to distinguish the invention from the prior art. Record p. 584:

“The fruit distributing means comprises supporting and guiding means, namely, the conveyor 10, and guide means 12, 13, arranged alongside of the grading element and adjusted to receive the fruit therefrom and to deliver the same at longitudinally distributed points, for example to a series of bins. The machine is of especial advantage in delivering to a series of bins where longitudinal extension is greater than that of the grading element, thereby giving more room for the packers, and for that purpose the distributing means is constructed so that its delivery portion is of greater longitudinal extension than the grading element.”

Of the new series of claims (Record p. 586) the

5th, 7th and 8th were rejected, the same reading as follows:

5. The combination with a grading element adapted to deliver graded fruit at different longitudinal portions of the element, a series of bins whose longitudinal extension is greater than the longitudinal extension of the grading element, guiding means for guiding the fruit from the grading element to a series of bins, and means for adjusting the longitudinal position of the outer ends of said guiding means.

7. In combination with a grading element, a distributing apparatus therefor comprising a conveyor traveling horizontally and longitudinally of the grading element and inclined downward away from said grading element, and guiding means arranged along the conveyor and forming chutes for the discharged fruit, said guiding means being adjustable longitudinally of the conveyor.

8. A distributing apparatus for the grading element comprising a horizontally traveling conveyor and guide means arranged along the conveyor and forming chutes for directing the graded fruit to the point of discharge from said conveyor, said guide means being adjustable to shift the point of discharge longitudinally of the conveyor.

Claims 5 and 7 of the new series were of such scope that if allowed they would have included the Camel-back machine of the prior art, the Rayburn patented apparatus, also the apparatus of the Thomas Strain patent; while Claim 8 if allowed.

would have been directly readable on and anticipated by the Thomas Strain patent.

The Examiner, when rejecting these claims, did not have before him the Camel-back devices of the prior art which were used long prior to the invention of the said Fred Stebler, and which devices are disclosed by defendants' Photo Exhibits O, P and P¹.

From a reading of the rejected and cancelled claims it will be noted that patentee Stebler, when appearing as applicant before the United States Patent, attempted to cover *broadly any and all forms of means associated with a horizontally traveling conveyor*, which would form or tend to form chutes for guiding or directing fruit to the bins or any portion of the bin or bins desired, as is evidenced by the first and second rejected claims filed in connection with his application for Letters Patent. By the rejected and cancelled Claims 5, 6, and 7, filed in connection with his amendment, after the cancellation of his originally applied for Claims 1, 2, 3, 4, and 5, the applicant endeavored to cover broadly any form of a distributing apparatus *comprising a longitudinally traveling conveyor with guiding means arranged along the conveyor forming chutes for the discharged fruit*, which means were *adjustable longitudinally of the conveyor*.

By the cancellation of these claims, applicant admitted that each and every element called for by said claims and the combination thereof was old in the prior art and disclosed thereby, consequently, he cannot at this time be permitted to have the claims of the Letters Patent so construed as to

cover that which was cancelled during the prosecution of the application while pending in the Patent Office. It will be noted that the rejected and cancelled claims did not require that the guiding means which formed the chutes be arranged diagonally or transversely of the traveling carrier, nor did said rejected and cancelled claims limit the guiding means to any particular form as to longitudinal adjustment, nor did original Claims 1 and 2 nor Claims 7 and 8 of the new series of claims require that the longitudinal extension of the series of bins be greater than the longitudinal extension of the grader.

To so construe the claims of the Letters Patent as to give thereto at this time the construction which counsel for appellee now seeks to have placed thereon, is equivalent to asking the Court to so construe the claims of the patent as to cover that which the Patent Office refused to grant, and which was cancelled from the application. The action of the Patent Office in the rejection of a claim and the acquiescence in the rejection thereof by the applicant, is binding on the patentee, and the Court cannot place a different construction thereon from that given by the Patent Office.

As stated in *Keystone vs. Phoenix*, 95 U. S. 274:

“As patents are procured *ex parte*, the public is not bound by them, but the patentees are. If the office refuses to allow him all he asks, he has an appeal. But the courts have no right to enlarge a patent beyond the scope of its claim, as allowed by the Patent Office, or the

Appellate Tribunal to which the contestants' applications are referred. When the terms of a claim in the patent are clear and distinct, as they always should be, in a suit brought upon the patent, the patentee is bound by it."

"This Court has often held that when a patentee, on the rejection of his application, inserts in his specification, in consequence, limitations and restrictions for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been construed if such limitations were not contained in it."

Roemer vs. Peddie, 132 U. S. 315;
Leggett vs. Avery, 101 U. S. 256;
Sargent vs. Hall, 114 U. S. 63;
Bragg vs. Fitch, 121 U. S. 478.

"Complainant is not at liberty now to insist upon a construction of his patent which will include what he was expressly required to abandon and disallow as a condition of the grant."

Sutter vs. Robinson, 119 U. S. 530.

"If an applicant, in order to get his patent, accepts one with a narrower claim than that contained in his original application, he is bound by it."

Shephard vs. Garrigan, 116 U. S. 593.

"A claim admitted by the Patent Office and acquiesced in by the patentee should not be enlarged by construction beyond the fair interpretation of its terms."

Haines vs. McLaughlin, 135 U. S. 584.

"Where applicant has put in a claim in the

Patent Office to cover more broadly his process, and afterwards struck it out on rejection, it is well settled by numerous cases in this Court, that under such circumstances, a patentee cannot successfully contend that his patent should be construed as if it still contained the claims which were so rejected and withdrawn."

Royer vs. Coupe, 146 U. S. 524.

" * * * must be read and interpreted with reference to the rejected claims, and to the prior state of the art, and cannot be construed to cover either."

Knapp vs. Morse, 150 U. S. 21.

"Patentee had acquiesced in the rejection of his claim and couldn't claim the benefit thereof, or of an equivalent construction of the claims allowed."

American vs. Pennock, 146 U. S. 26.

As the prosecution of the application progressed the number of claims were gradually increased, there finally appearing in the case twenty claims, but neither of said claims in scope equalled that of the rejected and cancelled claims above quoted.

The examiner finally rejected the claims appearing as Claims 1, 2, 3, 4, 6, 7, 8, 9, 12, 13, 14, 15, 16, 17, 18, 19, and 20 of the patent, on reference to several prior patents, mainly, however, on reference to the prior Rayburn and the prior Thomas Strain patent.

From this final rejection an appeal was taken to the Board of Appeals in the Patent Office, which

Board reversed the final rejection of the Examiner and allowed the appealed claims.

The decision of the Board of Appeals appears in full (Record pp. 675-77). In reversing the Examiner, the Board did so on a finding that the prior art did not disclose devices wherein *the delivery portions of the distributing means is greater than the longitudinal extension of the grading element*.

From an examination of the file-wrapper of the Stebler application which eventuated in the grant of the Stebler distributing means of the patent in suit, it will be noted that the argument advanced for the Stebler invention when presenting the appeal and which was accepted by the Board of Appeals, was that the invention resides in an extension or prolongation of a series of fruit receiving bins to a distance beyond the grading element, so that a comparatively short grader could be employed in connection with bins extended much there beyond, and for the disposition of the guiding means was advanced the contention that by the use thereof (diagonally disposed relative to the endless carrier), the sized fruit could be carried or conveyed from any given discharge outlet for the sized fruit to a position of discharge extended beyond the discharge outlet for other sized fruit, and that this form of distribution could be maintained without causing an intermixture of the sized fruit, or in other words, the integrity of the sized fruit preserved or maintained. On reference to the drawings and descriptive matter of the patented device,

we find the only form of guides employed to be guides which are pivoted at a point adjacent each discharge outlet of the grader or sizer for the sized fruit, and extended diagonally of the endless carrier to direct the fruit into the fruit receiving bins, each of said guides being provided with a telescopic member or section so as to permit such an extension of the guide as would, at the option of the operator, permit of the guides being extended such a distance as to carry the fruit to a bin situated beyond the sizing aperture for another size of fruit, and this without permitting the fruit from the two discharge apertures to intermix. If the guides disclosed by the said Letters Patent be removed, the sized fruit will not flow properly into the bins designed to receive the same, but there will be an intermixture of the sized fruit, and the operation of the sizer becomes useless, inasmuch as such intermixed fruit would have to be resized for commercial purposes.

That we are correct as to the foregoing it is only necessary to refer to the decision of the Board of Appeals, passing on the question as to the patentability of the claims held herein to have been infringed, the Board of Appeals considered Claim 1 as representative of the other claims, stating in its decision (Record pp. 675-76) as follows:

“Claim 1 sufficiently represents the appealed claims and is as follows:

“1. The combination with a fruit grading element constructed to deliver fruit at different longitudinal portions, of traveling supporting

and distributing means extending laterally from the grading element and inclined downwardly away therefrom, the longitudinal extension of the delivery portion of the said distributing means being greater than the longitudinal extension of the grading element."

"Rayburn shows a fruit grading element constructed to deliver the fruit at different longitudinal portions, and distributing means extending laterally from the grading element and inclined downwardly away therefrom. In Rayburn also the receiving bins are so distributed that the two lines thereof are longer than the length of the grading element. Rayburn fails to meet the claim, however, in that his distributing means is not 'traveling,' nor is the language of the latter part of the claim, to-wit, 'the longitudinal extension of the delivery portion of the said distributing means being greater than the longitudinal extension of the grading element,' readable upon Rayburn. The Examiner takes the view, however, that 2276,2) applicant has but substituted for the delivery means of Rayburn that of Stevens, Strain or White. The distributing means of White and Strain are clearly unadapted for applicant's device and in order to be used therewith would require such modification as to entirely lose their identity."

Considering each claim held to have been infringed by applicants, we find that,

Claim 1 requires in the combination, traveling, supporting and distributing means extending laterally from the grading element and inclined downwardly away therefrom, *the longitudinal extension of the delivery portion of the distributing means*

being greater than the longitudinal extension of the grading element.

This is the Thomas Strain patented apparatus, excepting it be differentiated therefrom by reason of the fact that the *longitudinal extension* of the delivery portion of the distributing means is greater than the *longitudinal extension* of the grading element.

Claim 2 requires in the combination called for, a conveyor traveling longitudinally of the grading element, *and guiding means* arranged along the conveyor *forming chutes* to guide the fruit and *bins arranged along the length of the said conveyor* and at the sides thereof.

Again, we have the invention of the Thomas Strain patent, unless the claim means that the conveyor and the bins are extended beyond the grading element, and that the guiding means shall form distinct chutes to guide the fruit transversely of the conveyor.

Claim 3 requires that the conveyor extended longitudinally under the grading element shall extend *beyond the end thereof* and that there shall be *a series of bins whose longitudinal extension is greater than the longitudinal extension of the grader.*

Claim 5 contains the same limitations as embraced in Claims 1 and 3, with the additional limitation, that means be provided for *adjusting the longitudinal position of the outer ends of the guiding means.*

At this point reverting to the specification of the Stebler patent for an understanding of the term, traveling and supporting distributing means as called for by said claims, we find, that during the course of the prosecution of the application in the Patent Office, the applicant, by amendment, inserted the following to define the construction, and which appears between lines 68 and 75, page 2 of the specification:

“The fruit distributing means comprises supporting and guiding means, namely, the conveyor 10, and guide means 12, 13, arranged alongside of the grading element and adjusted to receive the fruit therefrom and to deliver the same at longitudinally distributed points, for example, to a series of bins.”

Therefore, by the act of the applicant while in the Patent Office, with the particular form of distributing means as set forth and described, the Board of Appeals allowed the rejected claims, based on the theory, as expressed in its decision, that the distributing means extended to fruit bins projected a distance beyond the grading apparatus. This could be accomplished by no form of distributing means other than a form which would provide chutes diagonally disposed relatively to the endless conveyor, and such chutes at one end being arranged adjacent to one of the discharge apertures of the fruit runway and extended in a diagonal direction to the fruit bins.

Claim 2 is limited over Claim 1, and Claim 3 over either of said claims, and Claim 5 being further limited by requiring that means shall be provided

for *adjusting the longitudinal position of the outer ends of the guiding means.*

By reference to the specification and drawings of the Letters Patent, we find the only means for adjusting the longitudinal position of the outer ends of the guiding means to reside in the *telescopic outer end section 12.*

Claim 6 requires that the guiding means arranged along the conveyor shall form *chutes for directing the fruit to the bins.*

Inasmuch as a number of the bins are extended a length beyond the grader, these chutes must be disposed at a transverse inclination to the conveyor and lead from the discharge outlets of the grader. Otherwise, said grading means could not serve as chutes for leading the fruit to the bins.

Claim 7 requires that a traveling conveyor be arranged beneath the grader and be of *greater length than said grader*, a series of bins arranged at the sides of the conveyor and means in conjunction with said conveyor for directing the fruit along the conveyor.

If this claim be not construed to mean that the bins shall be extended a distance beyond the grading element and further limited to the extent that the guiding means for the sized fruit shall extend diagonally from each *grade outlet* to the fruit receiving bins, then the said claims would be readable on the device of the Thomas Strain patent, Complainant's Exhibit 3, and be void by the disclosure thereof, for the said Thomas Strain patent discloses in combination with a grading element and a

series of bins, *a conveyor traveling longitudinally under the grading element and along the side of the series of bins, with guiding means* (36 and 36-B), arranged along the conveyor to guide the sized fruit to the bins, and the said members 36 and 36-B of the Thomas Strain patent diverge toward the bins and form chutes for the sized fruit. It is therefore required that such a construction be placed on the guiding means, conveyor, and series of bins, as will distinguish the same from the invention of the said Thomas Strain patent, and such a construction, in order to save the claims, can only be placed thereon as to require that the bins and endless carrier shall be extended a distance beyond the grading element, and that the guiding means shall be extended diagonally from the fruit outlets of the grader to the fruit receiving bins.

Claim 8 is limited to the guide means being *adjustable relative* to the conveyor and so constructed as to form *a chute*, and further limited by the requirement that the *chute* so formed shall direct the graded fruit to the receiving bins.

Claim 11 is more restricted than any of the foregoing claims, for the requirements are that the *guides shall form chutes* for guiding the fruit to the bins, that the bins shall have *adjustable walls*, and that the chutes shall be *adjustable to shift the longitudinal position of their outer ends in accordance with the longitudinal position of the walls of the bin*.

By the fore-portion of Claim 11, the patentee explains what is meant by the expression "chute,"

stating that the graduated rotary member of the grader and the endless conveyor for propelling the fruit to be sized through the grader form a "way or chute."

Claim 14 is restricted to the guiding means associated with the traveling conveyor, being of such a construction as to *form chutes along the conveyor to guide the fruit to the bins.*

Unless this claim be restricted to guiding means extended from the discharge outlets for the sized fruit to the fruit receiving bins to form chutes arranged at an inclination transversely of the traveling conveyor, the same is anticipated by the invention of the Thomas Strain Letters Patent. However, like Claim 11, the patentee defines in the forepart of the claim what is meant by a "chute," and to utilize such a form of chutes, they must be extended from the discharge outlets for the sized fruit to the fruit receiving bins.

Claim 15 requires that the traveling separating and distributing means extending under the grader be inclined *downwardly* away therefrom, that the longitudinal extension of the delivery portion of the said distributing means be *greater than the longitudinal extension of the grader*, and further that a series of bins be arranged along said *distributing means.*

This claim only differs from similar considered claims in expressly defining the construction of the distributing means. The same limitation appears as to the distributing means and bins being ex-

tended a distance beyond the longitudinal extension of the grader.

Claim 19 is substantially the same as the non-infringed Claim 18. It is limited to guiding means forming *separated chutes along the conveyor for directing the fruit*.

Each and every element of this claim is found in the Thomas Strain patent, unless there be read into the claim, either that the distributing means are extended beyond the longitudinal extension of the grader and that the chutes are extended from the discharge outlets for the sized fruit to the bins, and that the bins arranged alongside of the distributing means be in length co-extensive therewith.

That our interpretation of the invention of the Stebler patent as to the guiding means associated with the traveling conveyor constituting chutes extend transversely at an inclination to the said conveyor and that it required two walls to form a chute, we direct attention to the following testimony of appellee's expert witness Knight, (Record pp. 258-9):

“Q. Have you a copy of the Complainant's Exhibit No. 2, Mr. Knight?

“A. Yes.

“Q. The first Stebler?

“A. Yes.

“Q. In the device of the Fred Stebler patent in suit, Complainant's Exhibit No. 2, the chutes disclosed therein are arranged at a transverse inclination to the longitudinally traveling belt for the sized fruit, are they not?

“The Court: Read the question.

“(Last question read by the reporter.)

“A. Yes.

“The Court: I don’t know what that is all about. Show me on that thing what you said.

“A. (Indicating to the Court): These chutes formed by these guides are arranged at a transverse inclination to the traveling belt.

“The Court: Oh, yes.

“Q. (By Mr. Acker): Now, how many of those guides does it take to constitute a chute, Mr. Knight?

“A. Well, of course, a chute is formed by the space between two adjacent guides.

“Q. That is, it takes the two inner walls of two guides to form the chute?

“A. Yes.

“Q. And it is those chutes formed by the two guides which guide the sized fruit from the sizing outlet to the bin into which it is to be deposited; is that correct?

“A. Yes.

“Q. Do means other than these chutes appear in the said Stebler patent for guiding and directing the sized fruit from the grading member to the bins to receive such bins?

“A. Well, there is—in case the belt is inclined, it is gravity which tends to cause it to move; in fact, in lines 88 to 85, page 3 of the patent, it is stated that one of the objects of inclining the conveyor is to cause the oranges to roll without having to rub forcibly against the guiding means.”

That a short grader is utilized under the Stebler invention and the distributing means and bins extended a distance beyond the longitudinal extension of the grader, the same witness testified as follows, (Record p. 260):

“Are you familiar with the device known as the Ish grader, and covered by Letters Patent No. 458,442?

“Mr. Lyon: Just a moment. That is objected to as not cross-examination.

“The Court: I will overrule the objection.

“Mr. Acker: It is cross-examination, your Honor.

“The Court: Go ahead. I have overruled it.

“Mr. Acker: It appears in the patent, your Honor, and forms a part of this patent. This witness has testified he understands the patent.

“A. Yes.

“Q. You have examined those machines in operation, have you not?

“A. Yes.

“Q. What is the length of the grader of the Ish—known as the Ish or California grader under the Ish patent?

“A. As I say, my memory for dimensions is very poor, but as I remember it, it is a very short grader.

“Q. Now, what is the length of the bins—that is, the total all over length of the bins that are employed in connection with the Stebler distributing system, and as disclosed by the Stebler Patent, Plaintiff's Exhibit No. 2?

“A. With the same qualification, I should say about 40 or 50 feet; that is just a guess.

“Q. Well, about 40 feet; and the Ish grader to which he makes reference here, is about 12 feet?

“A. 12 or 15 feet, I should say.”

We maintain, to preserve the validity of Claims 1, 2, 3, 5, 6, 7, 8, 11, 15 and 19, there must be placed on the elements thereof such a construction as will differentiate the same from the invention of the Thomas Strain patent, and this differentiation can only be found to reside in the distributing means being extended beyond the longitudinal extension of the grader and in the guiding means which form the chutes associated therewith being extended from the discharge outlets of the grader diagonally of the endless carrier to the fruit receiving bins so as to form separated guide chutes, each member of the chutes being pivotally connected to the frame of the apparatus adjacent each discharge outlet.

We submit from the above analysis of the claims of the patent covering the Stebler distributing system, that the only construction that can be reasonably placed thereon is the construction given to the claims by the Board of Appeals when allowing the same on appeal from the rejection thereof by the Examiner, and that is, that the bins and the traveling conveyor shall be extended a distance beyond the fruit grader, and that the guide means which form the chutes shall be extended from the grade outlets diagonally of the traveling conveyor to the fruit receiving bins. If the guide chutes, under the

disclosure of the Stebler patent, are not extended from the discharge outlets for the sized fruit diagonally of the endless conveyor to the fruit receiving bins, no sized fruit can be delivered to the fruit receiving bins and maintain the integrity of the size separation.

It may be safely said in complainant's patent that in order to carry out the invention described therein, that the apparatus so constructed thereunder must employ the following associated combinative elements:

1. That the traveling conveyor and bins arranged along the side thereof be extended longitudinally a distance beyond the longitudinal extension of the grader.

2. That the guiding means associated with the traveling conveyor be of such a construction as to form distinct or separated chutes extended from each discharge outlet of the grader for the sized fruit and diagonally of the conveyor to the bin or bins for the reception of such sized fruit.

3. That the guiding means forming the chutes be of such a character as to permit of the same leading the sized fruit from the discharge outlets of the grader to fruit receiving bins situated at a distance removed from the longitudinal termination of the grader.

At the hearing, counsel for appellee was requested to specify which of the claims of the Stebler Letters Patent he claimed to have been infringed by the defendants; he enumerated Claims 1, 2, 3, 4, 5, 8, 11, 12, 14, 15, 16, 17, 18, 19 and 20 (Record page 108).

In preparing the interlocutory decree counsel voluntarily eliminated Claims 12, 16, 17, 18, and 20 and incorporated Claim 7 as an infringed claim. Claim 4, the Court held, not to have been infringed, but this one was not known to counsel for appellants until the discovery was made (after perfecting the appeals to this Court) that the document forwarded by counsel to appellee did not constitute the decision of the Court.

It is somewhat difficult to understand why it is if Claims 16, 17, 18 and 20 are not infringed, that infringement can be held as to the subject matter of the claims decreed to have been infringed, inasmuch as the claims apparently mean one and the same thing, only being differentiated by shadows and play on words.

CLAIMED INFRINGEMENT.

We cannot refrain from criticizing the manner in which appellee endeavored to mislead the lower court as to an understanding of the operation of the appellant's machine, so far as relates to the operation of the claimed distributing feature of the apparatus, the said apparatus being illustrated by complainant's Photo Exhibits 4, 5, 6, 7, and 8 (Record pages 536 to 544).

It appears from the testimony in this case, and more particularly by the testimony of the complainant's expert witness, Arthur P. Knight, and defendant's witnesses Milligen and Ofstad, that prior

to the completion of the installation of the alleged infringing machines, appellee Stebler, his expert witness, Knight, and his counsel, Mr. Lyon, visited the packing house of the appellants, while the machines were under course of construction and installation, this visit being about November the 12th, 1915, as testified to by expert witness, Knight (Record p. 240) stating that the Photo Exhibits 5, 6, 7, and 8, or at least some of them were taken during the course of the day in which he visited the packing houses, for the purpose of inspecting these machines. On page 241 of the Record, near the bottom thereof, Mr. Knight states, that he did not see the machines in operation, and on Record page 242, he testifies that only one visit was made to Porterville, for the purpose of inspecting these machines, but that they visited the packing houses twice during the course of the same day. On page 268 of the Record, the witness was asked whether the barrier pieces of the appellants machines were removed from a longitudinal position and placed at an inclination transverse of the traveling belt so as to form what appears in complainant's Photo Exhibit 5, as a chute for directing the flow of the sized fruit into the fruit receiving bins, and in answer to said question, said that he did not know, and on Record page 269, stated, that he examined the machine prior to its being photographed, and that at such time the barrier strips were not set at an inclination or obliquely so as to form guide chutes, as disclosed by complainant's Photo Exhibit 5. On Record page 270, the witness states, that he

did not arrange the barriers in the manner disclosed by said Photo Exhibit, and did not know by whom they were so arranged. Now what happened during the course of the visit of the parties to the packing house of the appellants is, that not finding barrier strips or pieces arranged or associated in connection with the fruit sizing apparatus so as to form guide chutes or runways, someone of the party took the barrier pieces and so placed the same as to occupy the position illustrated by appellee's Photo Exhibit No. 5, and after so arranging the barrier pieces or strips, a photograph was taken thereof and the photograph so taken introduced as Exhibit No. 5 on behalf of the complainant and argument made therefrom that these barrier pieces were intended to serve the same purpose as the guide means of the Stebler patent, to provide downwardly inclined chutes arranged transversely of the longitudinally movable carrier and extended from the discharge outlet of the sizer to the fruit receiving bins situated for the reception of such sized fruit. In other words, an incomplete machine was found; that is, a machine under course of construction, the visiting party took certain portions and so arranged the same that a photograph taken thereof would give color to the claim that the elements were designed to form chutes for directing the sized fruit from the discharge outlets of the grader to the fruit receiving bins. A more misleading Exhibit was never before introduced into a case to uphold or support a claim for infringement. It was a deliberate attempt to make out an alleged infringe-

ment on the part of the complainant and his witnesses. The barrier strips employed in appellants machine arranged in any such manner as disclosed by appellee's Photo Exhibit No. 5, would totally destroy the usefulness of the machine for the work intended to be accomplished thereby. Even witness Knight testified, (Record page 270), that if the barrier strips of the appellants machine were arranged in the manner illustrated by Photo Exhibit No. 5, that only one of said strips would serve any useful function, the same being the middle one, which would serve to direct the fruit forwardly from the discharge outlet.

Appellant's witness Milligen, Secretary and Manager of the Porterville Citrus Association, testified that when the machines were installed for operation, that the barrier strips or pieces were never arranged, as disclosed by said Photo Exhibit 5, (Record page 299), and in answer to question (Record page 302) "What means, if any, were arranged transversely of the traveling belt in the machine used by the defendant and installed at the time you have testified to for conveying the fruit from the discharge outlets to the fruit-receiving bins?" "A. None whatever; the delivery of the fruit is directly into the bin."

On Record page 304, the witness testified, that the fruit flows by gravity from the discharge outlets of the grader into the fruit receiving bins, unless the gravity flow be obstructed. Record pages 305, 306 and 307, the witness states, that the only use of the barrier pieces or "slats" as he terms

them, is to distribute the fruit evenly into the bins and to even up the flow of the fruit throughout the bins, preventing the same pyramiding, so to speak, within the bins. And the witness further advises us, (Record page 303), in response to question, (commencing on Record page 302):

“Please state whether or not in the machine as installed in your packing-house and as used by the defendant company, whether the bins for receiving the sizing the sized fruit extended beyond the sizing or grading member of the said apparatus.

“A. No, sir; they do not extend beyond the sizing apparatus.”

Witness Brookhart, in answer to question (Record page 336), as to how the fruit which was sized moved or flowed toward the receiving bins, testified:

“A. Well, the fruit flowed out of the fruit aperture in a direct line into the bins, but in order to prevent the fruit from piling up in any one point, there was what we call barrier boards interposed to change the point of discharge into the bin and spread the fruit over the bin so it would be even and not overflow on the floor or on the table.”

The witness further states that the barrier boards, when employed were placed parallel with the supporting table over which worked the conveyor belts. In answer to question, (Record page 338), as to whether the barrier boards were arranged transversely of the belts or longitudinally of the belts, testified:

“They were arranged longitudinally of the belts; there was no other way they could be used and perform the function for which they were intended.”

And in reply to question, as to whether the barrier boards were ever arranged as disclosed by complainant's Photo Exhibit No. 5, testified (Record page 339):

“No, sir; these are not placed correctly; none of them was placed in that position at any time I was in the house. If they were used at all, they were placed longitudinally with the belt.”

Witness Ofstadt, foreman of the Porterville Citrus Association (Record page 385), in explanation as to how the fruit flowed from the grade outlets of the appellants' sizers, toward the receiving bins for the sized fruit, testified:

“Why, the fruit after it was sized went through the aperture and by gravity run into the bins. When the fruit piled up at one point in the bin, we sometimes pulled it down with our hands, which was the quickest way of doing it, and sometimes we put in a barrier to send the fruit to another point in the bin so as to even the fruit out.”

And he testified (Record page 386), that the barrier boards when used in appellants' machine served the same purpose as when the hand was employed for evening up the fruit within the bins. And in answer to question (Record page 386) whether complainant's Photo Exhibit No. 5 correctly dis-

closed the arrangement of the barrier pieces as employed by him at any time while he had charge of the machines, testified:

“The barriers as shown in this photograph were never placed in this position while I was in the employ of the Porterville Citrus Association during the operation.”

Although the barrier boards or pieces were only utilized in the appellant's machine at certain times during the operation of the machine, and when used were always arranged parallel with the longitudinal traveling conveyor and never transversely thereof, and were not intended nor designed by the maker of the machine to be so employed, nevertheless, complainant Stebler, and those visiting the packing house of the appellants and prior to the completion of the installation of the alleged infringing machine, deliberately positioned the barrier boards in a manner never intended to be positioned by the manufacturer thereof and so positioned the same in order to make it appear that the use thereof was to form chutes for guiding and directing the fruit from the discharge outlets of the sizer at an inclination transversely of the traveling conveyor and into the fruit receiving bins, as disclosed by complainant's Photo Exhibit No. 5. The only purpose of so arranging the barrier boards and producing a photograph illustrating such arrangement, was to heighten the resemblance of the appellants' machine as much as possible to appellee's patented apparatus and to lead the Court into the belief that the barrier boards formed separate and distinct

chutes for guiding the fruit transversely of the conveyor to the fruit receiving bins, as is accomplished by and which is the function of the guide means of the Stebler patent.

Inasmuch as the sizer element employed in connection with the appellant's machine is the Parker Modified Sizer, heretofore held by this Court not to be an infringement of Claims 1 and 10 of the Strain Re-issue Patent, the only point remaining on which appellee can hope in this Court to sustain claimed infringement resides in the fact, that in the appellants' machines at times during the operation thereof, one or more barrier boards or pieces arranged parallel with the traveling conveyor are employed for the purpose of varying the point of discharge for the sized fruit relative to the fruit receiving bin or bins, in order to prevent the pyramiding or piling up of the fruit within the bin; in other words, to secure even distribution of fruit therein. If the barrier boards or pieces were arranged at an inclination transversely of the traveling conveyor, as illustrated by appellee's Photo Exhibit No. 5, there could not be accomplished an even distribution of the fruit within the fruit receiving bins, for the sized fruit flowing by gravity from the discharge outlet of the sizer would be directed to one point relative to the fruit receiving bin, approximately to the center thereof, and all sized fruit would discharge into the bin at one point and cause the pyramiding thereof, instead of evening the fruit within the bin. It would be a needless and useless arrangement, as it would

cause the pyramiding of the fruit to a greater extent than if permitted to flow directly by gravity cross-wise of the conveyor into the fruit receiving bin.

APPELLANTS' MACHINE.

In order that the Court may have a clear understanding of the machines as used by the appellants, we reproduce herewith cuts illustrative of the said machine, one of which illustrating the apparatus as normally used without the employment of the longitudinally disposed barrier pieces, said view illustrating the gravity flow of the fruit from the discharge outlets of the sizer transversely of the endless conveyor and into the fruit receiving bins. In the cuts the letter A designates the Parker Modified type of sizer, which having heretofore been considered by this Court in connection with Appeal Case 2772, the opinion being reported in 240 Fed. p. 703, it is needless to describe the detail construction thereof, it sufficing to state that the sizer as disclosed by the drawing is co-extensive in length with the supporting table or frame piece B, over which travels the endless conveyors C and C', and that the series of fruit receiving bins D are arranged alongside of and co-extensive with the frame piece or supporting table B. The fruit as sized escapes from the sizer through the discharge outlets E, there being a discharge outlet for each fruit receiving bin. As the fruit leaves any given discharge outlet, it flows by gravity downwardly trans-

Fig-1-

PARKER MODIFIED GRADER

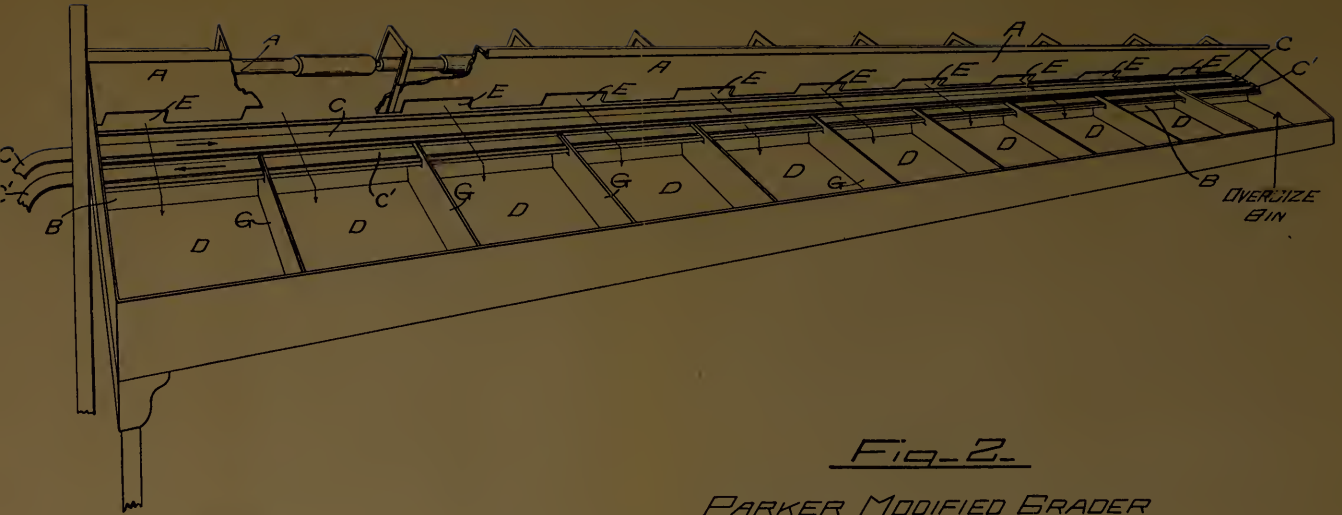
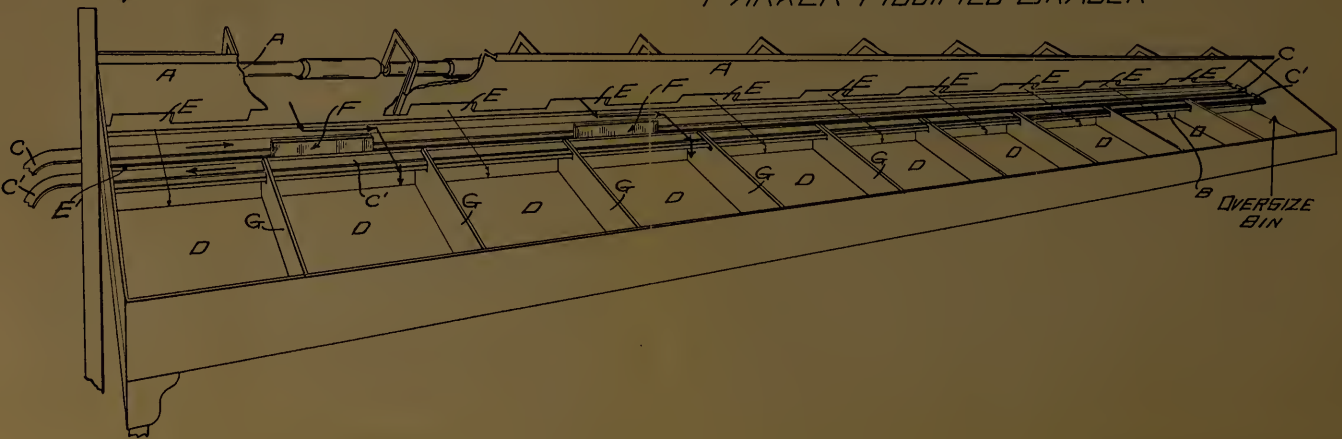


Fig-2-

PARKER MODIFIED GRADER



versely of the longitudinally movable conveyors or carriers and drops into the bin adapted for the reception of such sized fruit, the arrows indicating the gravity flow travel of the sized fruit from the discharge outlets of the sizer to the bins. At times, it happens where there is an excess run of fruit through one or more of the discharge outlets, the tendency is for such excess flow of fruit to cause the fruit to pyramid or pile up at one side or one portion of the fruit receiving bins and by so doing preventing an even distribution of the fruit within the bins. Where this happens and two or more packers are situated at the bin or bins, the work mainly falls to one packer or the packer working at that portion of the bin where the fruit is piled, requiring that the hand be employed for working down the fruit and scattering the same evenly within the bin, so that all of the packers or operators may work to advantage. Where this occurs, the operator places a barrier board F, within the longitudinal groove E', of the supporting table or frame B for the reception thereof, and as the barrier piece is slideable longitudinally within said groove, it acts as a barrier to arrest the downward gravity flow of the fruit and change its direction of discharge to a point within the bin desired by the operator. It is apparent from an inspection of Fig. 2 of the drawings that such is the sole function of the barrier piece, its only use being to change the point of discharge of the fruit into the fruit receiving bin. Like the Camel-back machines, appellants' Photo Exhibits O P and P', the transverse partition pieces G of the fruit bins, are longitudinally ad-

justable so as to permit of the bins being increased and decreased in width at the will of the operator. It may be stated, that appellants' apparatus is protected by United States Letters Patent No. 1,145,079, granted under date of April 6, 1915, to George D. Parker, for an IMPROVED SIZING APPARATUS.

To hold this apparatus to be an infringement of Claims 1, 2, 3, 5, 7, 8, 11, 14, 15 and 19, as set forth in the Interlocutory Decree appealed from, it is necessary,

1. To find that the longitudinal traveling conveyors and the series of fruit receiving bins have a longitudinal extension greater than the longitudinal extension of the sizer, or, in other words, that a short grader be employed in connection with the extended traveling conveyor and series of bins.

2. That there be found in appellants' machine, guiding means forming chutes to direct the flow of the sized fruit transversely of the longitudinal traveling conveyor to deliver the same into bins situated beyond the sizer.

3. That the longitudinal adjustable barrier pieces at times employed in appellants' machine and when so employed arranged parallel of the longitudinal traveling conveyor, constitute chutes for directing the sized fruit from the discharge outlets of the sizer to the fruit receiving bins.

It is earnestly submitted that the appellants' machines differ from the appellee's patented apparatus in the following respects:

1st. The fruit receiving bins are not extended beyond the fruit sizer as called for, illustrated and described in the Stebler patent.

2nd. No provision is provided for in appellants' machine for conveying or guiding sized fruit from the discharge outlets of the sizer to bins situated beyond the said sizer, as called for by the Stebler patent.

3rd. In the appellants' machine there are no chutes disposed diagonally of the conveyor which guide the fruit discharging from the discharge outlets of the sizer to bins other than the bins for the reception of such sized fruit, as provided for in the Stebler patent.

4th. In the appellants' machine there are no chutes or any form of guiding means employed which are arranged transversely of the longitudinally movable carrier.

5th. In the appellants' machine the normal working thereof is without the employment of the longitudinally adjustable barriers for evening the discharge of the fruit relative to the fruit receiving bins, whereas, in the Stebler patented machine it is essential that the guide chutes be employed at all times in connection with the longitudinally traveling conveyor and that they be arranged transversely of the said conveyor.

In the present case the appellants' machine is, in its general aspect a return to the prior art, and differs from the appellee's patented machine in the same manner and to the same extent as the said

patented machine differs from the machines of the prior art, for in appellants' machine the short sizer called for by the Stebler patent is discarded and a long sizer of the prior art resorted to, which is co-extensive with the length of the traveling conveyor and the series of fruit receiving bins, as in the case of the Thomas Strain Patent No. 775,015 (Record page 525-535). The guide chutes extended from the discharge outlets of the sizing member to the fruit receiving bins extended a distance therefrom called for by the Stebler patent, have been dispensed with, and in the appellants' machine a return is made to the utilization of a longitudinally movable barrier for controlling the discharge of the fruit from the longitudinal conveyor relative to any given point within the fruit bin situated for the reception of such sized fruit, the same being a return to the Thomas Strain patent and utilization of a simpler type of longitudinally adjustable barrier to that shown by the element 36-B of the said Strain patent. The difference between appellants' longitudinally movable barrier and the longitudinally movable barrier 36-B of the Thomas Strain patent, residing in provision being made whereby under normal working of the apparatus the said barrier is not employed; whereas, in the device of the Thomas Strain patent the longitudinally adjustable barrier 36-B is attached to and forms a permanent portion of the apparatus. In fact, the longitudinally adjustable barrier of appellants' machine performs a function corresponding to that of the longitudinally adjustable member 36-B of the Thomas Strain patent. This we

not only ascertain from a reading of the Thomas Strain patent, and the knowledge of the operation of the barrier member of appellants' machine, but are so told by the testimony of Thomas Strain, Sr. (Record p. 424); by the testimony of witness Ofstadt (Record pages 385-386); by the testimony of witness Thomas Strain, Sr. (Record page 320); by the testimony of witness Milligen (Record page 305); by the testimony of witness Brookhart (Record page 336); and further by the testimony of appellee's expert witness, Knight, which testimony is as follows:

"Q. (By Mr. Acker): And the part 36 then serves as a longitudinally disposed barrier for arresting the transverse movement of the fruit as it flows from the grading rod toward the fruit receiving bin, is that correct?

"A. Yes.

"Q. And to that extent it serves the same purpose, does it not, as the barrier employed in the defendants' device for arresting the line of travel of the fruit flowing by gravity from the sizing member towards the fruit receiving bin?

"A. Yes.

"Q. Now, what purpose does the part marked 36-B in the device of the Thomas Strain patent of Defendants' Exhibit Number 3 serve?

"A. It determines the particular point at which the fruit will be deflected from the depression in the conveyor and discharge into the bin.

"Q. That member 36-B is longitudinally adjustable relative to the longitudinal traveling carrier member, is it not, Mr. Knight?

“A. Yes.

“Q. And what is the purpose or what function is performed by the member 36-B of the said Thomas Strain patent?

“A. The purpose or function of this is to discharge the fruit into the bin at a given point so as to distribute the fruit uniformly throughout the bin, the idea being that if the fruit is allowed to run into the bin from the grader at different points along the bin there will not be an equal distribution.”

EQUIVALENTS.

After the hearing in the lower court, request was made that brief be filed as to the question of Equivalency, and undoubtedly the court must have had in mind, that while the appellants' machine did not contain the elements called for by the Stebler patent and disclosed by the drawings thereof, the elements of appellants' machine might constitute an equivalent of the elements of the Stebler patented device.

In this connection, we submit, that in order to find that the appellants' machines have embodied therein an element or elements the equivalent of the element or elements called for by the combinative claims of the appellee's patent, the testimony must show that the devices utilized in the appellants' machines were at the time of the invention of the Letters Patent in suit, and prior thereto, known equivalents for the devices claimed to have been infringed, for, as stated by the Supreme Court in the case of Gill vs. Wells, 89 U. S. 1:

“Repeated decisions of this Court have settled the rule in such cases that if the ingredient substituted by the defendant for the one left out in the defendant’s machine was a newly discovered one, or even an old one performing some new function, and was not known at the date of the plaintiff’s patent as a proper substitute for the ingredient left out, the charge of infringement cannot be maintained.” Citing *Seymour vs. Osborne*, 11 Wall. 555; *Vance vs. Campbell*, 1 Black, 428; *Prouty vs. Ruggles*, 16 Pet. 341.

One device cannot be held to be a mechanical equivalent of another device unless it is capable of performing the same function in substantially the same manner and for the same purpose; or, in other words, three things are essential: First, there must be identity of results; second, there must be identity of means; third, there must be identity of operation.

American Can Co. vs. Hickmott Asparagus Can Co., 137 Fed 86. (Decision by Judge Morrow.)

Even if the machines do function the same, such would not make out a case of infringement, and by function, as here expressed, we mean the common function of sizing fruit and conveying the sized fruit to fruit receiving bins, for the action which produces such result, must be the same in the two machines.

“On a legal construction of this claim, anything which does not possess this function of this action, no matter to what extent in other particulars it may answer its cause, it does not infringe.”

Eppler vs. Campbell, 86 Fed. 143.

“That the defendant’s meter, and the meter of the Young patent may effect the same result, is not determinative of the question of infringement.”

Pittsburgh vs. Pittsburgh, 109 Fed. 644;
Water-Meter vs. Desper, 101 U. S. 332;
Westinghouse vs. Brake Co., 170 U. S. 537.

“That there the apparatus has the capacity of readjusting the position of the packer in the well, and re-setting it above or below its original position, is not conclusive of the question of infringement.”

Masseth vs. Larkin, 119 Fed. 171.

“As this is not the only way in which the parts may be attached, it was incumbent upon the plaintiff to show that the defendant used castings and bottom plates; otherwise, infringement is not proved.”

Canada vs. Michigan Mal. Ir. Co., 124 Fed 486.

As stated by this Court:

“It must be remembered that the patent sued on is in no sense a pioneer one, but a mere improvement. In such cases, the patentee is limited to the precise devices and the combination shown and claimed in his patent.”

Cumming vs. Baker, 144 Fed. 395.

We are asking in the present case for the application of that law which counsel for the appellee herein requested the lower court to apply against the patented structure of the complainant in the

case of Wilson vs. Union Tool Co., A-4 and B-62, and as upholding the claim of non-infringement and the non-application of the doctrine of equivalency, counsel for complainant in said case not only cited to the Court the decisions herein cited on behalf of these appellants, but directed attention in addition thereto to the case of Seabury vs. Johnson, 76 Fed. 456, citing the claim therein in issue, which read as follows:

“A sulphur candle provided with a surrounding band of metal projecting slightly above the upper side of end of the main portion or body of the said candle, substantially as described.”

Counsel for appellee herein urged this decision as against the application of the doctrine of equivalency, and stated, quoting from his brief filed in said case:

“The defendant’s device was similar, except that, instead of a metal band, he used a band made of paper chemically treated so as to be rendered incombustible. Complainant claimed that the paper when so prepared became an equivalent for the metal band and was an infringement. But the Court held that while the invention might have warranted the patentee in claiming a band of incombustible material, he had not done so, but had limited his claim to a metal band.”

This decision applies with equal force to the present case. See further:

Brown vs. Stilwell & Bierce Manufacturing Co., 57 Fed. 731;
 Harris vs. Allen, 15 Fed. 106;
 Klein vs. Russell, 19 Wallace, 433;
 Smith vs. Putnam, 45 Fed. 245;
 Buffington Iron Bldg. Co. vs. Eustic, 65 Fed. 804;
 White vs. Dunbar, 119 U. S. 47;
 Hardison vs. Brinkman, 155 Fed. 962.

To apply the doctrine of equivalency in this case is to ignore the testimony present by the record herein and give such an interpretation to the claims of the patent in suit as to disregard the changes which patentee Stebler made over the devices of the prior art, and the inventions disclosed by the patents of the prior art, and more particularly by the patent granted Thomas Strain. It would be required to make the claims of the Stebler patent, embrace the mode of operation or combination of parts of those prior devices. In addition to the citations before given, we direct attention to *Howe Machine Co. vs. National Co.*, 134 U. S. 394; *McCarty vs. Railroad Co.*, 160 U. S. 116; *Railroad Co. vs. Mellen*, 104 U. S. 118; *Blades vs. Ram*, 27 Fed. 97.

“The patentee may bring the defendants within the letter of his claims, but if the latter has so changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of the statute has to be convicted when he has

done nothing in conflict with its spirit and intent.”

Westinghouse vs. Boyden Co., 170 U. S. 568.

Appellants’ device in general construction and mode of operation conforms to the invention of the prior Thomas Strain Patent 775,015. This patented device is not an anticipation of the Stebler invention, when the Stebler invention is properly construed, and the machine employed by the appellants if prior in point of time to the Stebler invention would constitute no closer an approach to the Stebler patented construction than the Thomas Strain Patent 775,015. As appellants’ machines would not anticipate if earlier, they cannot infringe either direct or as an equivalent.

As stated by this Court in the case of Riverside Heights Orange Growers’ Association vs. Stebler, 240 Fed. p. 709:

“The rule applicable to the question thus presented is that a construction which would not anticipate cannot infringe.

“Cook v. Sandusky Tool Co. (U. S. Supreme Court) 28 L. Ed. 124; American Tool Co. v. Streat, 85 Fed. 700, 706, 28 C. C. A. 18; Cleveland Co. v. Chicago Co., 135 Fed. 783, 68 C. C. A. 485; Grever v. United States Hoffman Co., 202 Fed. 923, 926, 121 C. C. A. 281.”

The working parts of the appellants’ said machines do not produce that identity of results which flow from the use of the appellee’s machine; nor is there that identity of means between the members of appellants’ machine as to produce the results of

the appellee's machine, nor is there that identity of operation in the appellants' machine which corresponds to the identity of operation of the appellee's patented distributing system. The appellants in the use of their machines cannot accomplish that which is attained by the use of the appellee's machine, and vice versa, the appellee, in the use of his machine, cannot accomplish that which is accomplished by the use of the appellant's machine. Where this condition exists, the doctrine of equivalents does not apply.

That our construction of appellee's Letters Patent is the only just and reasonable construction that can be given thereto, is obvious. Actions often speak louder, and frequently more truthfully, than words. We find in the present case the drawings and specification of the complainant Stebler's patent for the distributing system illustrates and describes an apparatus wherein a series of bins are projected a long distance beyond the grader, and that the guiding means are so arranged that the fruit is guided from its passage through the discharge apertures directly to the bins, said guiding means being arranged transverse of the endless carrier, and forming separated chutes. When the machines are built or constructed and installed on behalf of appellee, and by the appellee under his Letters Patent, we find the installation conforms to the only constructed device which is illustrated by the drawings of the Letters Patent, and described in the specification thereof, and we have before us no evidence disclosing an apparatus manufactured or constructed

under the said Stebler distributing patent, wherein a series of bins was not extended a long distance beyond the fruit sizer and wherein the guiding means for the sized fruit consisted of any form of device other than that illustrated and described in said Letters Patent, to-wit, the diagonally disposed guides pivoted at one end within the sphere of the discharge outlets and continued diagonally of the conveyor to the receiving bins for the sized fruit. We find that the appellant users have not infringed on any of the claims of the Stebler distributor patent, when said claims are construed in the light of the prior art and the self-imposed limitations placed thereon by the patentee to induce the grant of the Letters Patent therefor; that to place a construction on the claims of the Stebler distributing apparatus other than the construction which we have placed thereon, is to render the claims void as being readable not only on the invention disclosed by the prior Thomas Strain patent, but on the devices of the prior art.

BURDEN OF PROOF.

There has been no testimony presented other than the incorrect Photo Exhibit No. 5, for the establishment of a charge of infringement.

Thus a hearing on the charge of infringement, and in such cases, the full burden of proof falls on the complainant.

“The burden is upon the plaintiff to estab-

lish both the allegation of invention and that of infringement.”

Mitchell vs. Tillghman, 86 U. S. 287.

“The burden of proof of infringement is upon the plaintiff.”

Price vs. Kelley, 154 U. S. 669.

“To establish infringement, there must be a preponderance of the evidence in complainant’s favor.”

Be’ Ne’ vs. Jeantet, 129 U. S. 683.

“The burden of proof rests upon the complainant to show a completed act of infringement.”

Gray vs. Grinberg, 159 Fed. 138.

Appellee Stebler failed to respond to the burden placed on him. On the contrary, as heretofore pointed out, the testimony of the witnesses in the present case is to the effect that in the appellants’ machine no chutes are employed for directing the fruit from the grade aperture transversely of the endless carrier to the bins; that no means are employed whereby the sized fruit may be carried or delivered into bins located beyond the fruit grader; that no guide means are necessary in connection with the delivery of the sized fruit from the grade apertures to the fruit receiving bins, due to the fact that the sized fruit moves into said bins by gravity flow from the discharge apertures of the sizer; that the longitudinally movable barriers when used in appellants’ machines are only employed for the pur-

pose of maintaining an even distribution of the fruit relative to the fruit receiving bins, and to prevent the pyramiding of the fruit which otherwise would occur when an excess flow of any one or more sizes takes place. These facts are abundantly proven by the witnesses. There is no testimony produced on behalf of appellee illustrating the operation of the machines when in use by the appellants. The only evidence before the Court as to infringement is the Photo Exhibits of the apparatus taken before the same were completed by the manufacturer thereof and installed for operation. The witnesses positively deny that the longitudinally movable barriers of the appellants' machine were ever arranged in the manner in which they were deliberately placed by appellee for the purpose of making photographs to be used as exhibits and which do appear as Complainants' Photo Exhibits 4, 5, 6, 7, 8 (Record pages 536-544).

CONCLUSION.

It is not our contention that Claims 1, 2, 3, 4, 5, 6, 7, 8, 11, 14, 15 and 19 are anticipated by the devices of the prior art when the said claims are properly construed, but we do most earnestly contend that if the interpretation urged for these claims by the appellee is to be given thereto, then the claims are anticipated by the devices of the prior art, and more particularly so by the invention of the Thomas Strain Patent No. 775,015, of Nov. 25, 1904.

Under the interpretation which has been given to these claims, we respectfully submit:

1. That our Assignment of Errors 1 and 2 are well taken and should be allowed.

2. That our Assignment of Errors 3, 4, 5, 6 and 7 are well taken and should be allowed.

3. That our Assignment of Errors number 8 is well taken and should be allowed.

4. And that our Assignment of Errors 9 and 10 are well taken and should be allowed.

Respectfully submitted,

NICHOLAS A. ACKER,

Solicitor and Counsel for Appellants.